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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 770 Miscellaneous

BETHLEHEM STEEL COMPANY, *Petitioner*,

v.

CHARLES T. SAMUELSON, *Respondent*.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

W. BROWN MORTON, JR.
425 13th Street, N. W.
Washington, D. C. 20004

STANTON T. LAWRENCE, JR.
247 Park Avenue
New York, N. Y. 10017

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Bethlehem Steel Company prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit entered in the above-entitled case on September 27, 1963.

CITATIONS TO OPINIONS BELOW

The opinion of the Court of Appeals is reported as *Samuelson* v. *Bethlehem Steel Company*, 323 F.2d 944, 139 U.S.P.Q. 25 (5 Cir. 1963), and reverses an unreported decision of the United States District

Court for the Eastern District of Texas. Copies of the opinions of both courts below are printed in the Appendix hereto.

JURISDICTION

The decision and opinion of the Court of Appeals were announced on September 27, 1963 and the judgment thereon, a copy of which is printed in the Appendix hereto, was entered the same day.

An order denying a petition for rehearing was entered on December 11, 1963, and on December 18, 1963 an order was entered staying the issue of the mandate of the Court of Appeals for a period of thirty days, the stay to continue in force until the final disposition of the case by this Court, provided that within thirty days from December 18, 1963 there shall be filed with the Clerk of the Court of Appeals the certificate of the Clerk of this Court that this certiorari petition and record have been filed.

The jurisdiction of this Court to review the judgment of the Court of Appeals herein by writ of certiorari is conferred by 28 U.S.C. § 1254.

QUESTIONS PRESENTED

1. Does the presumption of validity conferred upon a patent by 35 U.S.C. § 282 impose upon a defendant in a patent infringement action, relying upon a defense of obviousness of the asserted invention in the light of prior patents, publications, and other documents of undisputed authenticity, the burden of establishing invalidity of the patent with the same degree of certainty required to sustain a criminal conviction, that is, "beyond a reasonable doubt"?

2. Is a judgment of non-infringement based upon a finding of non-equivalence reached by a trial judge through resolution of conflicting explanations and descriptions by qualified technical experts of complex engineering facts concerning structure and mode of operation of massive marine apparatus properly reversed as a matter of law by a court of appeals?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Constitution of the United States:

ART. 1, SEC. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

United States Code, Title 35—Patents:

§ 100. DEFINITIONS

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery. * * *

§ 101. INVENTIONS PATENTABLE

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the rea-

sonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 282. PRESUMPTION OF VALIDITY; DEFENSES

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

STATEMENT OF THE CASE

This is a civil action for patent infringement and the jurisdiction of the district court is conferred by 28 U.S.C. § 1338(a).

Complaint (R. 6) was filed on June 24, 1958 by Charles T. Samuelson, a retired professional shipbuilding engineer (R. 48-60), alleging infringement of United States Letters Patent No. 2,589,146 (R. 635), granted him on March 11, 1952 for an alleged invention of a Submersible Deepwater Drilling Apparatus, by the making and selling of a multi-million dollar mobile rig for drilling for tidelands oil in the Gulf

of Mexico (R. 60). The accused rig, named "Mr. Gus II", was designed and built by Bethlehem Steel Company in its shipyard at Beaumont, Texas in 1956-57 (R. 448-449).

The patent in suit relates generally to mobile off-shore oil drilling structures to be floated to a drilling site, set up for a drilling operation, and after the drilling operation is completed, re-floated for the purpose of relocating the structure at a new drilling site. Its asserted claims 1 and 10 define specifically a particular form of such a structure.

The trial judge succinctly described the accused rig, Mr. Gus II, in his Finding of Fact 29 (R. 610), and the Court of Appeals adopted his description (Appendix, *infra*, p. 4a). Petitioner cannot improve on this précis.

The Court of Appeals summarized Bethlehem's contentions about the relationship of Mr. Gus II and the patent in suit to the prior art in its opinion (Appendix, *infra*, pp. 4a-5a). Petitioner cannot improve on this summarization.

Mobile off-shore drilling rigs of the type involved in this action are taller than a 20-story building, cover more than four-fifths of an acre of the Gulf floor, and weigh as much as an ocean freighter (nearly 10,000 tons) (R. 456; 709). They are suitable for use only in areas where the depth of water, the soil conditions, and the topography of the ocean floor are such as exist in the Gulf of Mexico (R. 256; 443). Rigs of this sort have been used within the jurisdiction of the United States only in the Gulf coast tidelands, which are wholly within the territorial confines of the Fifth Judicial Circuit. Such structures are not used, and will not be used in the foreseeable future, in any other

geographical areas of the United States, its territories, or possessions.

The trial before the United States District Court for the Eastern District of Texas at Beaumont took five days. Plaintiff testified in his own behalf and introduced the testimony of an expert naval architect to explain his patent and his concept of the engineering significance of the structure and mode of operation of Mr. Gus II. Defendant urged the twin defenses of invalidity and non-infringement, the latter depending, of course, upon the valid scope, if any, accorded the asserted claims. In support of these defenses defendant proved the prior art by patents and publications, American, British, and Soviet Russian, and by contemporaneous private documents, all of undisputed authenticity and dating. It relied on the testimony of the designer of Mr. Gus II, two heads of college engineering departments who had practical experience in the off-shore field, and two practicing engineers in that field to explain its concept of the engineering significance of the patent, the prior art, and Mr. Gus II.

In all the testimony of seven witnesses went into the record, all except one appearing in person. Every witness was a professional engineer who had worked actively in the off-shore field. The trial judge, who heard the witnesses, after long consideration of the record, was able to weigh and compare the prior art, the structure and mode of operation of Mr. Gus II, and the specific claims of the patent asserted to be infringed. He concluded that the state of the art predating the plaintiff's invention foreclosed a broad interpretation of those claims and held that, while the asserted claims were narrowly valid, they were not infringed (R. 597).

The judgment of the Court of Appeals (Appendix, *infra*, pp. 15a-16a) reversed the holding of the District Court in these terms:

> "On Consideration Whereof, It is now ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, reversed; and that this cause be, and it is hereby remanded to the said District Court for a *finding* of infringement in accordance with the opinion of this Court [Emphasis added.];"

The opinion reflects material errors of the Court of Appeals concerning the structures and modes of operation of the patented, the prior art, and the accused devices, errors not made by the trial court.

The Court of Appeals not only reversed the District Court holding with respect to infringement, but also its holding as to the valid scope of the claims, since, in his Opinion Letter of December 29, 1961 (Appendix, *infra*, pp. 18a-19a), Judge Fisher had said:

> "Further, the Court agrees with Defendant that there does not appear to be any reasonable interpretation of Plaintiff's claim broad enough to encompass Mr. Gus II and yet, narrow enough to avoid the prior art."

In reaching its conclusion that the claims of the patent in suit were broadly valid, and thus expanding the limited scope of validity accorded it by the District Court, the Court of Appeals proceeded upon the stated belief:

> "Any reasonable doubt will be resolved against the party alleging the invalidity of a patent." (Appendix, *infra*, p. 6a).

REASONS FOR GRANTING THE WRIT

Outline

1. No conflict of decision between courts of appeals involving the validity and infringement of the patent in suit will ever arise as a practical matter since the particular branch of the industry affected is confined to the Fifth Circuit.

2. The Court of Appeals for the Fifth Circuit has built up an anomalous body of case law, culminating in the decision of this case on the stated basis:

> "Any reasonable doubt will be resolved against the party alleging the invalidity of a patent."

This body of law is clearly in conflict with the applicable decisions of this Court and contemporaneous decisions of other Courts of Appeals and District Courts. Continued application of this erroneous body of law can only result in the Fifth Circuit becoming a haven for owners of patents of doubtful validity.

3. There is a further conflict between the decision in this case, which follows other recent decisions of the Court of Appeals for the Fifth Circuit, and decisions of this Court and the other Courts of Appeals establishing the rule governing reversal of a determination of non-infringement by a district court. In these cases the Court of Appeals for the Fifth Circuit has, in conflict with the established rule, reversed specific findings of a trial court, based on conflicting testimony of qualified experts, that certain elements of an accused structure are not technically equivalent to allegedly corresponding elements of a claimed combination, and directed the entry of a finding on the issue of infringement.

ARGUMENT

Reason 1. No conflict of decision between courts of appeals involving the validity and infringement of the patent in suit will ever arise as a practical matter since the particular branch of the industry affected is confined to the Fifth Circuit.

No citation of authority is necessary in this Court to sustain the proposition that the Gulf Coast tidelands oil production industry is one of national importance.

It is a fact that the most prolific of these tidelands oil regions are off the coast of Louisiana in areas in which soil conditions make rigs of the type here involved especially useful (R. 256; 443) and it is a further fact that the Gulf Coast continental shelf is characterized by an essentially flat floor (R. 424-425). Although there is extensive production of oil off the California coast from wells located under the Pacific Ocean, that coast is notoriously rocky and steeply shelving and rigs of the type here involved have not been used and are not suitable for use there.

The legal significance of these facts upon this petition has been several times referred to by this Court in connection with writs of certiorari granted in patent cases.

In *Muncie Gear Co.* v. *Outboard Co.*, 315 U.S. 759 (1942), Mr. Justice Jackson, speaking for the Court, said, at pages 765-766:

> "... While there was no conflict of decision with respect to these claims, we granted certiorari in view of the questions presented and because the patent dominates a substantial portion of an industry so concentrated in the Seventh Circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely. 314 U.S. 594."

He was restating a position that had been twice earlier well stated by Mr. Chief Justice Stone, thus:

In *Exhibit Supply Co.* v. *Ace Corp.*, 315 U.S. 126, 128 (1942):

> ". . . Although there is no conflict of decision, we were moved to grant the petition by the nature of the questions presented, together with a showing that the industry affected by the patent is located in the seventh circuit so that litigation in other circuits resulting in a conflict of decision would not be likely to occur."

In *Schriber Co.* v. *Cleveland Trust Co.*, 305 U.S. 47, 50 (1938):

> "Petition for certiorari raising the question, among others, whether the Court of Appeals had erred in holding patentable a combination including one element not described in the original application for the Gulick patent and later added to it by amendment, and not described at all in the Maynard patent, was at first denied, there being no conflict of decision. 303 U.S. 639. We later granted certiorari, 304 U.S. 587, on a petition for rehearing showing that, notwithstanding the doubtful validity of the patents, litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit."

A conflict of decision in this case is improbable because of a concentration of the off-shore drilling industry in the Fifth Circuit.

Reason 2. The Court of Appeals for the Fifth Circuit has built up an anomalous body of case law, culminating in the decision of this case on the stated basis:

> **"Any reasonable doubt will be resolved against the party alleging the invalidity of a patent."**

This body of law is clearly in conflict with the applicable decisions of this Court and contemporaneous decisions of other Courts of Appeals and District Courts. Continued application of this erroneous body of law can only result in the Fifth Circuit becoming a haven for owners of patents of doubtful validity.

The interpretation of 35 U.S.C. § 282 into which the Court of Appeals for the Fifth Circuit has fallen erroneously clearly appears from the following quotations:*

a. *Fairchild* v. *Poe*, 259 F. 2d 329, 331, (5th Cir. 1958), where the court said:

> "... Of course, there is a presumption of validity which attends the grant of letters patent by the Patent Office, but this presumption can be overcome *if invalidity is proved beyond a reasonable doubt.*"

b. *Cameron Iron Works* v. *Stekoll*, 242 F. 2d 47, 20 (5th Cir. 1957), where the Court said:

> "... Other factors strongly influencing, and which we think are supportive of our conclusion that the patent is valid, are: (1) the presumption of validity which attends the grant of a patent by the Patent Office; (2) the rule that the burden of establishing invalidity of a patent shall rest on the party asserting it and that *any reasonable doubt will be resolved against him*, 35 U.S.C. § 282;".

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* Emphasis supplied.

c. *Jeoffroy Mfg.* v. *Graham*, 219 F. 2d 511, 519 (5th Cir. 1955), where the Court said:

> ". . . Other factors strongly influencing and, we think, reinforcing our conclusion as to the validity of 798 are: (1) that 'presumption of validity' which attends the grant of a patent by the Patent Office where, as here, it appears to have fully considered and distinguished the very prior art patents here principally relied upon as anticipation (Southern States Equip. Corp. v. USCO Power Equip. Corp., supra?; (2) the rule that the burden of proof of invalidity is on the party seeking to upset a patent's prima facie validity from issuance, and that *any reasonable doubt will be resolved against him*;".

Not surprisingly, this error on the part of their Court of Appeals has led the District Courts located in the Fifth Circuit into parallel error. For example, District Judge Bootle, in reliance on *Cameron Iron Works* v. *Stekoll*, *supra*, ruled in *Adams* v. *Columbus Manufacturing Co.*, 180 F. Supp. 921, 930 (M.D. Ga. 1960):

> "The presumption of validity is statutory, 35 U.S.C.A. sec. 282, and the rule is that the burden of establishing invalidity of a patent shall rest on the party asserting it, and that *any reasonable doubt will be resolved against the party asserting invalidity.*"

A more recent example of the influence of the error is to be found in *United States Pipe & Fdry. Co.* v. *James B. Clow & Sons, Inc.*, 205 F. Supp. 140, 152 (N.D. Ala. 1962). This case was affirmed by the Fifth Circuit without discussion of this point *James B. Clow & Sons, Inc.* v. *United States Pipe & Foundry Co.*, 313 F. 2d 46 (5 Cir. 1963).

The error of the Court of Appeals for the Fifth Circuit stems from a misconstruction of a decision of this Court in *Mumm* v. *Decker & Sons*, 301 U.S. 168 (1937). That case involved only the sufficiency of a complaint for patent infringement in which there was no affirmative allegation that the patentee had met each of the conditions of patentability imposed by statute. In ruling on this, Mr. Chief Justice Hughes said for the Court at page 171:

> "This construction is decisive of the present question. In a suit for infringement of a patent it is not a part of the plaintiff's case to negative prior publication or prior use or the other matters to which R.S. 4886 and 4887 refer. These are matters of affirmative defense. As this Court said in *Cantrell* v. *Wallick*, 117 U.S. 689, 695, 696: 'For the grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device described in the letters patent and of its novelty. *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U.S. 486; *Lehnbeuter* v. *Holthaus*, 105 U.S. 94.' The issue of the patent is enough to show, until the contrary appears, that all the conditions under which a discovery is patentable in accordance with the statutes have been met. Hence, the burden of proving want of novelty is upon him who avers it. Walker on Patents, § 116. Not only is the burden to make good this defense upon the party setting it up, but his burden is a heavy one, as it has been held that 'every reasonable doubt should be resolved against him.' *Id.*, *Cantrell* v. *Wallick*, *supra*; *Coffin* v. *Ogden*, 18 Wall. 120, 124; *Barbed Wire Patent*, 143 U.S. 275, 284, 285; *Adamson* v. *Gilliland*, 242 U.S. 350, 353. What must be so completely established by the defendant cannot be regarded as a part of the plaintiff's case which is to be set forth in his bill under the Equity Rule."

The quotation taken by Mr. Chief Justice Hughes from *Cantrell* v. *Wallick*, 117 U.S. 689, 696 (1886) was in itself a quotation taken from *Coffin* v. *Ogden*, 18 Wall. 120, 124 (U.S. 1873). The true rule intended to be reflected by this "chain quotation" was analyzed with customary clarity by Circuit Judge Soper in one of his last patent opinions, *Universal Incorporated* v. *Kay Manufacturing Corp.*, 301 F. 2d 140, 148 (4 Cir. 1962) where he said:

> "The plaintiff is also entitled to the benefits of the statute, 35 U.S.C. 282, which declares that a patent issued by the Patent Office shall be presumed valid and places the burden of establishing invalidity on the party asserting it. We do not think as the plaintiff contends that an infringer must prove invalidity beyond a reasonable doubt. The cases on which the plaintiff relies for this rule, to wit: Mumm v. Jacob E. Decker & Sons, 301 U.S. 168, 33 USPQ 247, and Radio Corporation of America v. Radio Engineering Laboratories, 293 U.S. 1, 21 USPQ 353, *were cases in which priority of discovery of the same invention was the issue rather than invalidity by reason of relevant disclosures of the prior art.*" [Emphasis added.]

The correctness of Judge Soper's analysis is amply borne out by examination of the decisions. The issue in *Cantrell* v. *Wallick*, *supra*, turned on the oral testimony of witnesses and as the Court observed it was a *prior use* which the defendants had "failed to show by preponderance of proof, much less beyond reasonable doubt", 117 U.S. 689, 695-6. In *Coffin* v. *Ogden*, *supra*, a prior use of a lock made by one Erbe was the issue and about the proof of that lock the Court had this to say:

> "Here it is abundantly proved that the lock originally made by Erbe was complete and cap-

> able of working.' The priority of Erbe's invention is clearly shown. It was known at the time to at least five persons, including Jones, and probably to many others in the shop where Erbe worked; and the lock was put in use, being applied to a door, as proved by Brossi. It was thus tested and shown to be successful. These facts bring the case made by the appellees within the severest legal tests which can be applied to them." 18 Wall. 120, 125.

Other cases of this Court involving the point at issue are *The Barbed Wire Patent*, 143 U.S. 275, 284 (1892); *Morgan* v. *Daniels*, 153 U.S. 120, 125 (1894); *Deering* v. *Winona Harvester Works*, 155 U.S. 286, 300 (1894); *Adamson* v. *Gilliland*, 242 U.S. 350, 353 (1917); and *Radio Corp.* v. *Radio Laboratories*, 293 U.S. 1, 7 (1934).

In every one of these cases, that which the defendant was properly required to prove beyond a reasonable doubt was the fact of the prior existence of the thing he relied upon to constitute the prior art. In not one of these cases was the issue of "invention over the sufficiently proved prior art", *i.e.* the issue of whether or not the claimed invention would have been obvious to the man skilled in the art at the time it was made, held to be subject to any such burden.

The reason for the rule is stated in *The Barbed Wire Patent*, *supra*, at pages 284-5:

> "... We have now to deal with certain unpatented devices, claimed to be complete anticipations of this patent, the existence and use of which are proven only by oral testimony. In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their lia-

> bility to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt. Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information. The very fact, which courts as well as the public have not failed to recognize, that almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny. Indeed, the frequency with which testimony is tortured, or fabricated outright, to build up the defence of a prior use of the thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer. The doctrine was laid down by this court in *Coffin* v. *Ogden*, 18 Wall. 120, 124, that 'the burden of proof rests upon him,' the defendant, 'and every reasonable doubt should be resolved against him.''

Other Circuits which have grappled with this problem have not been led into the error that pervades the recent Fifth Circuit Court of Appeals case law.

As long ago as 1923, the First Circuit Court of Appeals in *Slip Scarf Co.* v. *William Filene's Sons Co.*, 289 Fed. 641, 648 (1 Cir. 1923) had occasion to analyze the character of proof necessary to sustain the defense

of non-invention in passing on a charge to the jury. It ruled:

> "An exception was also taken by the plaintiff to the following portion of the charge, on the ground that it failed to properly state the character of proof necessary to sustain the defense of noninvention:
>
> 'When it comes to invalidating the patent for lack of invention—that is, because the step is nothing but a skilled workman's step—there the burden is still upon the defendant to satisfy you that the patent does not involve invention; but there it is sufficient if they satisfy you by a fair preponderance of the evidence. * * * If they satisfy you to that effect, as I have told you, the burden of proof on the part of the defendant is sustained, and you should invalidate the patent for lack of invention.'
>
> 'The questions as to the patent are whether the defendant has satisfied you by a fair preponderance of the testimony that the patent is void for lack of invention.'
>
> "Counsel for plaintiff has failed to point out wherein this charge is erroneous. We do not mean to say that he does not offer any argument in his brief where he has attempted to treat this matter; but, so far as we can see, nothing that he has said has any direct relation to it. Instead of discussing the character of the proof required of a defendant, where noninvention is the defense, he proceeds to discuss the question as though the defense under consideration was anticipation, which it was not. When the objection was taken the court replied:
>
> 'I differentiated, I believe, rather soundly between "invention" and "anticipation." As to anticipation, there is very good reason why the

> proof of that should be practically beyond reasonable doubt. * * *. As to invention, that goes on the preponderance of evidence. * * *."

To paraphrase the District Judge's differentiation in terms of the present patent statutes:

> "As to the facts made relevant by 35 U.S.C. § 102, there is very good reason why the proof of that should be practically beyond reasonable doubt. * * * As to the non-obvious subject matter required by 35 U.S.C. § 103, that goes on the preponderance of evidence. * * *."

The true status of the presumption of validity afforded by 35 U.S.C. § 282 was stated in *Rothe* v. *Ford Motor Company*, 253 F. 2d 353, 355 (D.C. Cir. 1959) thus:

> ". . . Appellee has correctly pointed out that the presumption of validity is hardly more than a procedural device to establish a prima facie case that cannot survive in the face of undisputed facts showing there is no invention."

This view has been confirmed by a recent decision of the Court of Appeals for the Second Circuit, *Gross* v. *Pfaudler Manufacturing Co.*, 314 F. 2d 196 (2 Cir. 1963).

It can hardly be otherwise. The matter which the doctrine of the Court of Appeals for the Fifth Circuit would require petitioner to prove beyond a reasonable doubt is the proposition that the differences between the invention of the patent in suit and the prior art are such that they would have been obvious in 1949 to the man skilled in the off-shore drilling art. This is the issue posed by 35 U.S.C. § 103 and this is an issue which this Court has characterized as one of law. *Mahn* v. *Harwood*, 112 U.S. 354, 358 (1884). It is one

which must be resolved by application of the "standard of invention" by the courts themselves.

In the present case there is no question about the historical accuracy of the anticipatory facts relied upon by petitioner, since most of them were in the form of publications and the others were supported by unchallenged documentary evidence, nor is there any question as to the sufficiency of their dating. The issue before the courts below was simply whether this body of unchallenged evidentiary fact was sufficient to establish the absence of patentable "invention" in the contribution, if any, made to the off-shore drilling art by the patentee.

The Court of Appeals itself correctly stated petitioner's position about "invention" in its Opinion (Appendix, *infra*, pp. 4a-5a), though in so doing it revealed by its choice of words a bias on the subject of petitioner's reliance on *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147 (1950) perpetuating a bias already displayed by it in its opinion in *Jeoffroy Mfg., Inc.* v. *Graham*, *supra*, at pp. 198-199. It may also be that petitioner's reliance on published foreign, in this instance Soviet Russian, art led the Court of Appeals into its error about the burden of proof of the issue of "invention". Whatever its motivation, on this issue, the Court of Appeals, perpetuating an erroneous line of cases in its Circuit, has ruled that the defendant carries the burden of "proof beyond a reasonable doubt". This is an anomalous and erroneous requirement and this Court should restore uniformity to the Circuits and the administration of the patent law by granting petitioner the writ of certiorari it prays for.

Reason 3. There is a further conflict between the decision in this case, which follows other recent decisions of the Court of Appeals for the Fifth Circuit, and decisions of this Court and the other Courts of Appeals establishing the rule governing reversal of a determination of non-infringement by a district court. In these cases the Court of Appeals for the Fifth Circuit has, in conflict with the established rule, reversed specific findings of a trial court, based on conflicting testimony of qualified experts, that certain elements of an accused structure are not technically equivalent to allegedly corresponding elements of a claimed combination, and directed the entry of a finding on the issue of infringement.

This "Reason" is based upon the principal ground that appellee finds it impossible to reconcile the judgment of the Court of Appeals with the exposition of the law in the opinion of this Court in *Graver Mfg. Co.* v. *Linde Co.*, 339 U.S. 605 (1950) at pages 608-610.

The Court of Appeals for the Fifth Circuit has ignored the admonition in the *Graver* case:

> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case." 339 U.S. 605, 609.

in that it must have considered the relation of the claims read in the light of the disclosure of the patent in suit to the prior art on the one hand and to "Mr. Gus II" on the other as a matter of law, or have fallen into the error of reversing the trial court on an issue of sharply contested fact. Yet petitioner is at a loss how such a comparison could have been made without the making of engineering rather than legal judgments.

The Court based its action (Appendix, *supra*, p. 14a) on its prior decision, *Cameron Iron Works* v. *Stekoll*, 242 F. 2d 17, 21 (5 Cir. 1957). That decision will not sustain its reversal of the District Court here. When

examined, the Court of Appeals in *Cameron* correctly did *not* reverse a finding of non-infringement made by a District Court based on the doctrine of equivalents, while, in the same case, it did reverse a like finding no application of that doctrine was involved.

The Court of Appeals for the Fifth Circuit has also ignored the admonition in the *Graver* case:

> "A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of appellate review, should not be disturbed unless clearly erroneous." 339 U.S. 605, 609

in that its Judgment (Appendix, *supra*, pp. 15a-16a) reverses and sets aside Findings of Fact 29-35 (R. 610) without explanation. To paraphrase *Graver*, p. 612, these findings are adequately supported by the record, certainly they are not clearly erroneous. That the Court of Appeals, at least sub-consciously, agrees that it has reversed a finding of fact is clear from its remand to the District Court as stated in that Judgment, "for a *finding* of infringement". [Emphasis added.]

CONCLUSION

For the foregoing reasons, this Petition for Writ of Certiorari should be GRANTED.

Respectfully submitted,

W. Brown Morton, Jr.
Stanton T. Lawrence, Jr.,
Counsel for Petitioner

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 19643

CHARLES T. SAMUELSON, *Appellant*,

versus

BETHLEHEM STEEL COMPANY, *Appellee*.

(And Reverse Title)

Appeals from the United States District Court for the Eastern District of Texas

(September 27, 1963)

Before TUTTLE, Chief Judge, WISDOM, and GEWIN, Circuit Judges.

WISDOM, Circuit Judge: Charles T. Samuelson, the plaintiff, appeals from the judgment in a patent infringement suit holding that his patent for a submersible offshore drilling rig, while valid, was not infringed by Bethlehem Steel Company's structure. The defendant cross-appeals.

Before and immediately after World War II there was a well-recognized need for a self-contained mobile drilling platform which could be used for both drilling and exploration in the exposed offshore waters of the Gulf of Mexico. There were two principal types of structure then in use. The fixed structure was merely a pile-supported platform built like a dock in the water with the drilling equipment placed on top of it. This structure was adapted for drilling only in bayous and shallow waters where a known field was located and was unsatisfactory for exploration purposes. The other type, the Giliasso or bayou drilling barge, had mobility but, like the fixed structure, was limited to use in shallow, sheltered waters. It was simply a large barge with drilling equipment located sufficiently high on an upper deck to be above the water level when the barge was sunk at the drilling site. To prevent the

barge from slipping during the drilling process, pilings fitted into tubes extending the depth of the barge were driven into the marine floor. In order to move the rig to another drilling location, the pilings were retracted, water was pumped out of the barge, and it was towed away. The major disadvantage of these barges was that they were restricted to use in fairly shallow water, because of the danger of capsizing during the sinking process and also because of stability limitations on the height of the upper platform.

After the end of World War II, a considerable amount of money and inventiveness were put into efforts to develop a mobile deep-water drilling rig which would not be dangerously unstable in rough weather and which could be firmly based on treacherously shifting ocean floors. The Samuelson invention was one of the products of this endeavor.

Samuelson's patent is directed toward the platform and does not include the drilling equipment or housekeeping facilities. In the plaintiff's structure the drilling equipment is placed on a buoyant working platform which, in turn, is connected by tubular columns to one or more submersible ground anchors, each of which has a buoyant chamber therein. The columns extend upward from the bottom of the ground anchors, through the buoyant chamber and loosely through guide means in the working platform so that the space between it and the ground anchors can be adjusted as desired. Within each column at the bottom of the ground anchor is a guide sleeve which directs the movement of a piling or spud. These pilings are driven into the ground after the ground anchors have been completely submerged and are resting on the Gulf floor. The pilings support no vertical weight and are intended solely to prevent horizontal shifting. Finally, means are provided to raise the working platform on the columns above the water and the lateral motion of the waves.

In operation, the mobile drilling platform is floated to the drilling location with the ground anchors drawn up against the buoyant working platform. They are then filled with water and sunk to the Gulf floor; the buoyant upper platform and connecting columns provide the necessary stability which prevents their capsizing during this process. Once the ground anchors are completely submerged and provide a stable base, the working platform is raised above the surface of the waves. Either before or after the elevation of the working platform, the spuds may be driven into the ground. Once the drilling operation has been completed, these steps are reversed, and the rig is floated away.

Samuelson began work on this invention upon his retirement from running his own shipyards in Beaumont, Texas, in 1947 and applied for a patent on October 6, 1949. Later that year, or early in 1950, he submitted plans of his invention to the defendant, Bethlehem Steel Company. Bethlehem disavowed any interest in obtaining rights under the patent and returned the documents. Bethlehem, without Samuelson's permission, made and kept copies.

Bethlehem had been engaged for some time in experimenting with various designs for mobile offshore drilling rigs and in 1954 finished construction on Mr. Gus I. This unit, although usable in deep water, did not furnish a satisfactorily stable base since it was constructed partially of piling supported at all times on location and was constructed entirely of piling supported at the critical times of being set up or removed from drilling position; the piling had to be driven and pulled while the remainder of the structure was floating in the water. This created serious hazards for its use on loose, sandy bottoms with fluid soil conditions. Mr. Gus I tilted and broke two pilings on its maiden voyage, and in 1957 it turned over in about thirty feet of water off the Texas coast when a thin sandy layer of soil gave way under the pilings.

In 1956, Bethlehem began work on the infringing structure, Mr. Gus II, while Mr. Gus I was still in operation. It was completed in 1957. The trial judge described the construction and mode of operation of Bethlehem's second offshore drilling rig as follows:

> " . . . Mr. Gus II uses as a ground anchor a single large steel hull sometimes called the 'mat.' This mat has four supporting columns, 10 feet in outside diameter and extending 232 feet upwardly from the bottom of the mat and attached to it. A buoyant working platform in the form of an upper hull or barge, is connected to these columns by the means of special hydraulic jacking systems which enable the platform to be moved up or down the columns to vary its space relationship to the mat at will. The jacking systems include guide tubes in the platform or upper hull through which the columns pass. Inside the columns, the bottom of which are open to the sea, are coaxial spuds or piles, seven feet in outside diameter, connected to the columns by an additional set of special hydraulic jacking systems by means of which the spuds can be pushed into the ocean bottom when the mat has been lowered by means of the platform jacks to rest thereon. The 130-feet long spuds are guided in the columns by a pair of narrow rings spaced 30 feet apart. These rings are each only some 6 inches high, are seven feet, one inch (7′ 1″) in inside diameter, and are located, one at the bottom of the mat and one 20 feet above the top of the mat."

The trial judge found that this structure does not infringe the Samuelson patent, and the plaintiff appeals from this holding.

I.

As is usual in such a suit, Bethlehem contests the validity of the Samuelson patent, alleging that it embodies nothing new, nothing that was not known to prior art, cit-

ing, of course, *Atlantic Works* v. *Brady*, 1882, 107 U.S. 192, 2 S.Ct. 225, 27 L.Ed. 438, and *Great A. & P. Co. v. Supermarket Equip. Corp.*, 1950, 340 U.S. 147, 71 S.Ct. 127, 95 L.Ed. 162. Samuelson's conceptual generalities were, Bethlehem insists, obvious to persons skilled in the art, and what was needed was metallurgical, mechanical, and hydraulic engineering to put the well-known generalities into a practical, working structure. Thus it points out that in 1947 the Hansen patent was issued, showing a lower buoyant hull connected by columns to an upper buoyant working platform, which, once the lower hull was ballasted and sunk on location, could be raised by a winch and cable arrangement above the water level. Although this patent shows no spud or piling arrangement, retractible spuds were quite commonly used in the Giliasso barges and as early as 1860 the Edwards British patent featured piles which were driven into the marine floor through guide sleeves at the bottom of each compartment of a bridge caisson which had been sunk to the marine bottom. A Russian device, which was described along with several other proposed rigs in an article translated in this country in 1947, provides for an offshore drilling rig placed on one pontoon which is supported on slidable columns attached to a lower hull, which is sunk. The article suggests that any of the structures described therein can be fixed to the sea bed by means of piles driven through the supporting columns. This device, the defendant points out, contains all the elements of the Samuelson patent except a provision for raising the upper pontoon above the water level, and this was a feature of Hansen and several other patents. In short, the plaintiff's invention was merely an aggregation of several well-known techniques with no rightful claim to uniqueness or patentability.

35 U.S.C.A. § 282 provides that

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

Any reasonable doubt will be resolved against the party alleging the invalidity of a patent. *Mumm* v. *Decker & Sons*, 1937, 301 U.S. 168, 171, 57 S.Ct. 675, 81 L.Ed. 983; *Cameron Iron Works* v. *Stekoll*, 5 Cir. 1957, 242 F.2d 17; *Jeoffroy Mfg. Co.* v. *Graham*, 5 Cir. 1955, 219 F.2d 511. Bethlehem has not met this burden. No prior invention disclosed the same combination of devices as the claims at issue in the Samuelson patent, and it is not at all clear that the entire invention would have been obvious to a person having ordinary skill in the art.

This Court has on several occasions held a patent invalid as a mere *aggregation* of old elements and not a patentable *combination*. For example, see *Murray Company of Texas, Inc.* v. *Continental Gin Co.*, 5 Cir. 1959, 264 F.2d 65; *Stubler* v. *Bright Leaf Industries, Inc.*, 5 Cir. 1958, 261 F.2d 383. An excellent explanation of "aggregation" is set forth in *Application of Worrest*, Ct. Cus. & Pat. App. 1953, 201 F.2d 930, 934:

> "The term 'aggregation' appears to be used by the courts in either one of two different ways. It is applied in one sense to a device having two or more unrelated, independent units or elements, each of which performs its functions separately, uninfluenced by and indifferent to the action of the other units. There is no essential or inherent correlation, or cooperation, or coordination of elements which mutually contribute to a common purpose or result, other than mere convenience due to juxtaposition or collection of the units in a common setting. It is applied in another sense (almost invariably preceded by a deprecating adjective as, for example, 'mere aggregation') to devices which really appear to be a combination of two or more units coacting or cooperating in the full sense of the term, but which the court regarded as not displaying the exercise of invention because no new or unexpected result was produced by the combination. It seems to

> us that the former is the correct use of the term. In the latter case, such a device should, in our opinion, properly be regarded as an unpatentable combination, and not as an aggregation."

In the case before us it cannot be said that Samuelson's structure has two or more, unrelated, uninfluenced units or elements. That arrangement is not present in the combination of claims 1 and 10. The various elements cooperate, they are not unrelated, and they do influence each other. When all the elements of claims 1 and 10 are used, the spud and guide sleeve arrangement can be used in only one particular portion of the sequence—when the ground anchor is on the ground. This is clearly specified in the claims. For example, claim 1 provides that " . . . said spud *when the anchor is submerged to rest on the underwater ground* arranged to be forced into the ground to retain the anchor in a fixed position . . . " Thus, the claim itself specifies coaction, an interaction between the spud, guide sleeve, and column arrangement with the remainder of the components of the combination.

Samuelson devised a structure which not only would be stable, regardless of the composition of the marine bottom, but would not be subject to lateral motion by either waves or underwater currents. Moreover, his particular device of spuds placed within guide sleeves inside the columns would sharply reduce the friction caused by marine growth and likewise reduce the likelihood of the spuds being bent during the retraction process. It is true that these favorable results were achieved principally through a combination of very old devices. "[But] a combination whether composed of all old, or some old and some new elements, is patentable if it achieves an altogether new and useful result. The life of such a combination is not to be destroyed by excision of its several parts without benefit of anaesthesia, nor is the cause of its vitality to be discovered by the prosecutor's retrospective dissection." *Bryan* v. *Sid*

W. Richardson, Inc., 5 Cir. 1958, 254 F.2d 191, 194, *cert. den'd* 1958, 358 U.S. 815, 79 S.Ct. 22, 3 L.Ed.2d 57. As the Supreme Court observed in *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 1911, 220 U.S. 428, 31 S.Ct. 444, 55 L.Ed. 527:

> "Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and, 'in the light of the accomplished result,' it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius.' [Citations omitted.] Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention."

We cannot now, with the benefit of hindsight, say that the particular combination of devices embodied in the Samuelson patent was as obvious in 1949 as it is fourteen years later. We affirm the finding of the validity of the patent in suit.

II.

Defendant next argues that any construction of the Samuelson patent narrow enough to avoid the prior art will be too limited to support a holding of infringement by its structure. Samuelson here is urging two claims, numbers one and ten. Claim one sets forth the following details:

1. (a) In a floating barge for subaqueous operations,

   (b) a buoyant working platform,

   (c) a submersible ground anchor below the platform and having

(d) a buoyant chamber therein,

(e) a tubular column extending upwardly from the bottom of said anchor and through said chamber and the top thereof, said platform having

(f) guide means through which said column loosely extends, the bottom of said anchor having

(g) a guide sleeve projecting upwardly into said column,

(h) a spud extending axially through said column and slidably engaging said sleeve, said spud when the anchor is submerged to rest on the underwater ground arranged to be forced into the ground to retain the anchor in a fixed position, and

(i) means for introducing water into the chamber for moving the column and anchor downwardly relative to the platform.

Bethlehem points out that while the mat in Mr. Gus II has some buoyant chambers which can be flooded, the columns do not pass through them, as stipulated by (e) they pass through the chambers that are permanently buoyant. Moreover, the mat itself is normally kept at substantially neutral buoyancy and is lowered by means of jacks, not by letting water into it. Bethlehem also denies that it has the "guide sleeves" called for in (g), since it employs two narrow "guide rings" spaced thirty feet apart to perform this function.

Claim 10, which incorporates claim 9 by reference, presents the following features:

9. (a) In a floating barge for subaqueous operations,

(b) a working platform,

(c) spaced submersible ground anchors below the platform and having

(d) buoyant chambers therein each of said anchors having

(e) spaced pairs of tubular columns extending upwardly from the bottom and through the chamber and top thereof, said platform having

(f) guide means, through which said columns loosely extend, the bottom of each anchor having

(g) spaced guide sleeves extending upwardly into an adjacent column,

(h) a spud axially movable in each of said columns and slidably engaging a guide sleeve therein, the spuds when the anchors are submerged to rest on the underwater ground to maintain the anchors in a fixed position, and

(i) fluid supply means in each of said columns communicating with its associated chamber for flooding the latter to lower the anchor so as to rest on the underwater ground.

10. In a floating barge as called for in claim 9 in which means mounted on the columns are operatively connected to the platform for raising the latter relative to the anchors and above the surface of the water when the anchors are submerged to engage the underwater ground.

In regard to claims 9 and 10 Bethlehem reiterates the differences between the Samuelson invention and Mr. Gus II in regard to guide sleeves, the particular type of chamber in the ground anchor through which the columns pass, and the means for lowering the ground anchor and contends that Mr. Gus II also does not have "spaced submersible ground anchors", since its ground anchor is a single large unitary mat. This feature of Mr. Gus II also precludes it from having "spaced pairs of tubular columns", because any "pairing" of the columns would be entirely arbitrary.

Bethlehem is able to avoid a finding of infringement, however, only by ignoring the doctrine of equivalents. As this Court stated in *Matthews* v. *Koolvent Metal Awning Co.*, 5 Cir. 1946, 158 F.2d 37, 40:

> "We are not concerned here with determining whether defendant's device, which plaintiffs charge is an infringement of the Matthews patent, is exactly the same in appearance or in form, but merely whether it is substantially the same in function. The doctrine of equivalency has never been a mere dry bones doctrine. Put forward to do justice and prevent defrauding by dissimulation and deceit, it should be, it has been, applied to give its equitable purpose effect. Not at all recondite or difficult of understanding or application, it is the mere expression and application of the view that like things are alike and that they are not made unlike by formal and non-substantial changes, no matter how cunningly contrived the dissimulation, how clever the changes in form."

The Supreme Court stated the essence of the doctrine in the leading case, *Graver Tank Co.* v. *Linde Air Products Co.*, 1950, 339 U.S. 605, 607, 70 S.Ct. 854, 94 L.Ed. 1097:

> "The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of Winans v. Denmead, 15 Howard 330, it has been consistently applied by this Court and the lower federal courts, and contains today ready and available for utilization when the proper circumstances for its application arise. 'To temper unsparing logic and prevent an infringer from stealing the benefit of the invention' (1. [sic] Hand in Royal Typewriter Co. v. Remington Rand, 168 F.2d 691, 692), a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result' Sanitary Refrigerator Co. v. Winters, 280 U.S.

30, 42 (3 USPQ 40, 44). The theory on which it is founded is that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape' Machine Co. v. Murphy, 97 U.S. 120, 125. The doctrine operates not only in favor of the patentee of a pioneer or primary invention, but also for the patentee of a secondary invention consisting of a combination of old ingredients which produce new and useful results. Imhaeuser v. Buerk, 101 U.S. 647, 655, although the area of equivalence may vary under the circumstances (citing cases)."

There is an especial necessity for applying this doctrine to a patent such as the one in suit, which has combined several pre-existing devices in order to arrive at a new and satisfactory solution to the problems of offshore oil and gas exploration and drilling. "Combination patents would generally be valueless in the absence of a right to equivalents, for few combinations now exist, or can hereafter be made, which do not contain at least one element, an efficient substitute for which could readily be suggested by any person skilled in the particular art." Walker, Patents, § 464, p. 1701.

Bethlehem has, we feel, merely substituted equivalent elements for some of the features in the combination and thus has not avoided the claims. It is clear that the two spaced "rings" in each column of Mr. Gus II and the "guide sleeves" required by both claims 1 and 10 serve the same functions of guiding the spuds and reducing the friction which would be entailed by a guide tube the entire length of the spud. The "rings" are each six inches wide and seven feet one inch in diameter and are shaped similarly to the "sleeves" in the Samuelson patent. We can see no convincing distinction between the two. The same is true of the requirement for a floodable chamber in the ground

anchor with a column extending therethrough. Mr. Gus II has a ground mat divided into several chambers, some of which are permanently buoyant, some permanently flooded, and some floodable. Although its columns pass through a permanently buoyant compartment, this does not, as James E. Steele, the designer of Mr. Gus II admitted, change the mode of operation of the structure. It is true, as plaintiff concedes, that the buoyancy of the mat is usually not varied but the defendant has stipulated that

> "Means are provided for regulating the water ballast in a number of the chambers in the ground anchor or mat so that the buoyancy of the mat or ground anchor may be changed from a positive buoyancy to a negative buoyancy, or vice versa, at will, under control from the working platform, regardless of the vertical spacing between mat and platform. (A body with a negative buoyancy will sink and a body with a positive buoyancy will float.)"

Since claim 1(i) merely requires some

> "means for introducing water into the chamber for moving the column and anchor downwardly relative to the platform,"

we think this feature is squarely met by Mr. Gus II, even though the "means for introducing water" into the floodable tanks of the mat are rarely if ever used.

Claim 1, then, is infringed by Mr. Gus II. What of the combined claims 9 and 10? Although their requirement that there be some "fluid supply means in each of said columns communicating with its associated chamber for flooding the latter to lower the anchor so as to rest on the under-water ground" seems to differ, at least in its specificity from claim 1(i), the defendant does not press this distinction between the two claims. It apparently accepts as correct the description by the plaintiff's expert

witness of the columns of Mr. Gus II as containing piping which connects them to the floodable tanks and is the means for introducing water into these compartments. Thus the only additional feature of claims 9 and 10 which is in issue is the requirement for spaced ground anchors having spaced pairs of tubular columns.

The U-shaped ground anchor of Mr. Gus II does not avoid this claim. The mat of defendant's rig was constructed in two parts which were then placed parallel to each other and connected by means of plating. There is no stipulation in claims 9 and 10 that the spaced submersible ground anchors must be disconnected, and, in fact, one of the drawings submitted with the Samuelson patent application shows two ground anchors connected by rigid trusswork. The conversion in Mr. Gus II of connecting trusswork into part of the body of the ground anchor itself is not a sufficient modification to avoid infringement.

This Court stated in *Cameron Iron Works* v. *Stekoll*, 5 Cir. 1957, 242 F. 2d 17, 21:

> "We agree with appellee that the question of infringement is usually a question of fact, and that the Supreme Court so declared in the Graver Tank Co. case. But the rule there announced is subject to this exception, and is that where, as here, the facts are undisputed and the case can be determined by a mere comparison of the structures, and extrinsic evidence is not needed for purpose of explanation or evaluation of prior art, or to resolve questions of the application of descriptions to subject matter, the question of infringement may be determined as a question of law, and that we shall do."

The same considerations apply in the present case. The structure and mode of operation of the infringing rig have been stipulated to by Bethelem. Thus this Court need only compare the claims set forth in the Samuelson patent

with the undisputed structure of Mr. Gus II in order to determine whether, as a matter of law, there is infringement. See *Industrial Instrument Co. v. Foxboro Co.*, 5 Cir. 1962, 307 F. 2d 783; *The Guiberson Corp. v. Equipment Engineers, Inc.*, 5 Cir. 1958, 252 F. 2d 431; *Matthews v. Koolvent Metal Awning Co.*, 5 Cir. 1946, 158 F. 2d 37.

We hold, therefore, that defendant's rig, Mr. Gus II, does infringe claims 1 and 10 of the Samuelson patent.

The judgment of the lower court is REVERSED and REMANDED for a finding of infringement.

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

October Term, 1962

No. 19643

D. C. Docket No. 4014 Civil

CHARLES T. SAMUELSON, *Appellant-Appellee*,

v.

BETHLEHEM STEEL COMPANY, *Appellee-Appellant*.

(AND REVERSE TITLE)

Appeals from the United States District Court for the Eastern District of Texas.

Before TUTTLE, *Chief Judge*, WISDOM, and GEWIN, *Circuit Judges*.

Judgment

This cause came on to heard on the transcript of the record from the United States District Court for the Eastern District of Texas, and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said

District Court in this cause be, and the same is hereby, reversed; and that this cause be, and it is hereby remanded to the said District Court for a finding of infringement in accordance with the opinion of this Court;

It is further ordered and adjudged that the appellee-appellant, Bethlehem Steel Company, be condemned to pay the costs of this cause in this Court for which execution may be issued out of the said District Court.

September 27, 1963

Issued as Mandate:

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS

P. O. Box 88

JOE J. FISHER
U. S. District Judge
Beaumont, Texas.

December 29, 1951

MESSRS. JAMES F. WEILER and JEFFERSON D. GILLER
Fulbright, Crooker, Freeman, Bates & Jaworski
Bank of the Southwest Building, 8th Floor
Houston 2, Texas

HONORABLE CLEVE BACHMAN
Orgain, Bell & Tucker
First Federal Savings Building
Beaumont, Texas

MESSRS. W. BROWN MORTON, JR. and
STANTON T. LAWRENCE, JR.
Pennie, Edmonds, Morton, Barrows & Taylor
247 Park Avenue
New York 17, New York

HONORABLE EWELL STRONG
Strong, Pipkin, Strong & Nelson
319 McFaddin Building
Beaumont, Texas

RE: CHARLES T. SAMUELSON v. BETHLEHEM STEEL COMPANY,
Civil Action No. 4014, Beaumont Division.

Gentlemen:

The Court has endeavored to give careful and deliberate study to the briefs filed by counsel, both orignal and reply, and have found them interesting and most informative. However, I must confess that the study and time which I have given this case has not made the decision any easier. I will make a few observations and general findings.

The Court is of the opinion that Plaintiff was taken advantage of by the Defendant when, in 1950, Mr. Samuelson submitted various documents to Bethlehem Steel Company disclosing his invention and inquiring if Bethlehem would be interested in obtaining rights under the patent application; and Bethlehem had copies made and kept same without the consent and permission of Mr. Samuelson. In view of this undisputed fact and the undisputed facts as to the history of the development of offshore drilling structures, it is reasonable to presume that some use was made by Bethlehem of the information obtained from the Samuelson patent in the construction of the highly successful offshore drilling vessel known as Mr. Gus II. Such facts, of course, cannot be ignored, but cannot be used as a basis for the Court's decision. The Court must, first, decide whether or not the patent is valid, and if so, secondly, was there an infringement by the Defendant.

As to the first question, the Court holds that U. S. Patent No. 2589146, issued to Plaintiff March 11, 1952, is valid. The patent issued by the U. S. Patent Office is presumed to be valid and the Court is of the opinion that the Defendant has not overcome the presumption by evidence of prior art which was, in the main, considered by the Patent Office in granting the Samuelson patent.

As to the question of infringement, the Court is of the opinion that although Mr. Samuelson has been wronged by the conduct of Bethlehem, and Bethlehem should feel some moral obligation to Mr. Samuelson, the construction of Mr. Gus II does not infringe Claims 1 and 10 and Claim 9 insofar as it affects Claim 10. The burden of proof being upon Plaintiff to show that Defendant infringed Claims 1 and 10, the Court is of the opinion that Plaintiff has failed to discharge this burden. Further, the Court agrees with Defendant that there does not appear to be any reasonable interpretation of Plaintiff's claim

broad enough to encompass Mr. Gus II and yet, narrow enough to avoid the prior art.

Therefore, judgment will be rendered, holding U. S. Patent No. 2589146 valid, but declaring that no claims of said patent is infringed by the vessel Mr. Gus II, with costs of Court adjudged against Defendant.

Counsel may have until February 1, 1962 to prepare appropriate form of judgment and proposed findings of fact and conclusions of law reflecting the Court's verdict.

Sincerely yours,

JOE J. FISHER,
(Joe J. Fisher).

cc: Mrs. Mary G. Wakefield
Deputy Clerk in Charge
U. S. District Court
P. O. Box 231
Beaumont, Texas

Office-Supreme Court, U.S.
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FEB 14 1964
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 770

BETHLEHEM STEEL COMPANY,

Petitioner,

v.

CHARLES T. SAMUELSON,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

JAMES F. WEILER
JEFFERSON D. GILLER
8th Floor, Bank of the Southwest Building
Houston 2, Texas
and
CLEVE BACHMAN
First Federal Savings Building
Beaumont, Texas
Counsel for Respondent

Of Counsel:
FULBRIGHT, CROOKER, FREEMAN, BATES & JAWORSKI

February, 1964

PRINTED IN U.S.A. — BY DELARUE/TEXAS

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OPINIONS BELOW

An adequate reference to the opinions delivered in the courts below is made in the Petition.

JURISDICTION

The jurisdictional requisites are set forth in the petition.

QUESTIONS PRESENTED

It is respectfully submitted that the following questions, rather than the questions urged by the Petitioner, are the ones correctly here presented.

1. In affirming the trial court's finding that the patent in suit was valid, which finding involved conflicting testi

mony and the credibility of witnesses, did the Court of Appeals err by stating in its opinion, "Any reasonable doubt will be resolved against the party alleging the invalidity of the patent (citing cases). Bethlehem has not met this burden. No prior invention disclosed the same combination of devices as the claims at issue in the Samuelson patent, and it is not at all clear that the entire invention would have been obvious to a person having ordinary skill in the art. * * * * "We cannot now, with the benefit of hindsight, say that the particular combination of devices embodied in the Samuelson patent was as obvious in 1949 as it is fourteen years later. We affirm the validity of the patent in suit."? (323 F. 2d 944, 948)

2. Was the Court of Appeals entitled to reverse the trial court's finding of non infringement where there is no dispute in the record on the controlling facts upon which the Court of Appeals based its action?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The constitutional and statutory provisions are adequately set forth in the Petition.

STATEMENT OF THE CASE

This is a civil action by Charles T. Samuelson for infringement by Bethlehem Steel Company of claims 1 and 10 of United States Letters Patent No. 2,589,146 granted to him March 11, 1952 for an invention in a Submersible Deep Water Drilling Apparatus. (R. 6, 19, 599) The only structure of Bethlehem accused of infringement is a large mobile offshore drilling rig named "Mr. Gus II" which was built and sold by Bethlehem at Beaumont, Texas in 1956-57. (R. 448-449)

The patent in suit relates generally to a mobile offshore drilling structure to be floated to a drilling site, set up for drilling operations, and after the drilling operation is completed, refloated for the purpose of relocating the structure at a new drilling site.

As stated by the Petitioner (Petition p. 6), "The trial judge succinctly described the accused rig, Mr. Gus II, in his Finding of Fact 29 (R. 610) and the Court of Appeals adopted his description (Appendix, *infra*, p. 4a)". Respondent concurs in this description as there is no issue in the evidence as to the construction and mode of operation of Mr. Gus II.

The trial before the United States District Court for the Eastern District of Texas in Beaumont took five days. With respect to validity the plaintiff testified in his own behalf, introduced testimony of a naval architect, introduced admissions of the designer of Mr. Gus II, and cross-examined defendant's witnesses.

In an attempt to sustain its burden of proving invalidity of the patent in suit Bethlehem introduced certain patents, publications, private documents, *and*, as stated in its Petition (p. 7):

> "... It relied on the testimony of the designer of Mr. Gus II, two heads of college engineering departments who had practical experience in the off-shore field, and two practicing engineers in the field to explain its concept of the engineering significance of the patent, the prior art, and Mr. Gus II."[1]

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[1] On page 6 of its Petition Bethlehem states, "The Court of Appeals summarized Bethlehem's contentions about the relationship of Mr. Gus II and the patent in suit to the prior art in its opinion (Appendix, infra, pp. 4a-5a)". Petitioner cannot improve on this summarization." It should be borne in mind that the portion of the opinion which Bethlehem is there referring to sets forth Bethlehem's *contentions*, not the court's holding, as to certain of the prior art. Much more than this went into the determination of validity.

The evidence on validity created sharp conflicts and involved credibility of witnesses.

As to infringement there is no issue as to the construction and mode of operation of Mr. Gus II for the plaintiff relied upon stipulated drawings, manuals, and photographs of Mr. Gus II produced by Bethlehem, Bethlehem's answer to interrogatories, and admissions by the designer of Mr. Gus II. (Pltf's Ex. 3 at R. 23-29, 147-149, Pltf's Exs. 10-G, 10-H, 10-I, 10-J, 10-M, 10-N, 10-T, 10-U, 10-V at R. 32, 33, 36, 37, 42, and 43, Interrogatories at R. 46, Admission at R. 265, 266, 461, 462)[2] The only comparison made by anyone of the claims of the patent in suit to Mr. Gus II was that made by the plaintiff's expert naval architect. (R. 139-155) Bethlehem very carefully did not ask its expert or any of its other witnesses to compare Mr. Gus II with the patent claims.

The trial court found the claims involved to be valid but not infringed. In its opinion letter of December 29, 1961 the trial court stated, "The Court is of the opinion that Plaintiff was taken advantage of by the defendant. . . ." (R. 615, 595)

Upon appeal the Court of Appeals affirmed the finding of validity and reversed the finding of non-infringement.

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[2] The question at the top of page 266 of the record should read: "Question: Then, as I understand, Mr. Gus II would function the same way, whether the columns pass through permanently buoyant tanks or floodable tanks, but for the strength of the mat you preferred to have them in the structure you do have them?" A portion of this question was inadvertently omitted from the printed record but it is present in the original transcript of testimony forwarded to the Court of Appeals at page 378 thereof.

ARGUMENT

Rule 19, which fixes the standard for granting writs of certiorari, requires there be "'special and important'" reasons for the writ. None such exist here. As the trial court found, "This case therefore involves the conventional issues in patent infringement suits . . .". (R. 598) This is just another patent suit turning on the particular facts involved in which the one who twice lost on validity and last lost on infringement seeks further review.

No Conflict Of Decision Involving The Validity And Infringement Of The Patent In Suit Exists But It Is Not True, Contrary To Bethlehem's Assertions, That As A Practical Matter The Patent In Suit Cannot Be Litigated Other Than In The Fifth Circuit.

Bethlehem (Petition pp. 10-11) seeks to excuse the admitted lack of conflicting decisions involving the patent in suit by asserting that structures of the type covered by the patent in suit do not operate other than in the Fifth Circuit and relies upon decisions in which certiorari was granted where the industry affected was concentrated in one location.

There is no evidence in the record, and Bethlehem apparently does not assert it to be true, that the patent in suit dominates any industry.

Without citing a record reference (and Respondent knows of none), Bethlehem (Petition p. 10) states that the California "coast is *notoriously* rocky and steeply shelving and rigs of the type here involved have not been used and are not suitable for use there." Respondent does not know of any such testimony. If by its use of the word "notoriously" Bethlehem is asking this Court to take judicial notice

of whether or not mobile offshore drilling rigs can operate outside the Fifth Circuit, Respondent joins with Bethlehem in such a request because a reference to the trade magazine "Offshore & Gulf Coast Oil Reporter", December, 1963, pages 39-42, published by Industrial Trade Publications, Conroe, Texas (reproduced in the appendix hereto) shows that mobile units are operating outside the Gulf Coast.

Additionally, the only other structure mentioned in the record as being one which infringes the patent in suit is the "S-66" owned by a company located in San Francisco, California. (R. 129, 201, Pltf's. Ex. 21A, R. 714)

There Is No Conflict Between The Reasoning Of The Fifth Circuit In Upholding The Validity Of The Patent In Suit And Applicable Decisions Of This Court And Other Courts Of Appeal.

Bethelehem here finds itself in the same position as the defendant in the *Graver Tank & Mfg. Co. v. Linde Air Prod. Co.*, 336 U.S. 271, 274, 93 L. Ed. 672, 676, where this Court stated when asked to review the question of *validity*:

> "Rule 52(a) of the Federal Rules of Civil Procedure provides in part: 'Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses'. To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which the trial court may be enlightened by scientific demonstrations. This trial occupied some three weeks, during which, as the record shows, the trial judge visited laboratories with counsel and experts to observe actual demonstrations of welding as taught by the patent and of the welding accused of infringing it, and of various stages of the prior art
>
> "

Bethlehem attempts to avoid the attitude expressed above by asserting in its "Questions Presented" and "Reasons For Granting The Writ" (1) that it attacked the patent relying solely upon uncontested publications and other documents and (2) because this was the nature of its attack the Court of Appeals erred in affirming the lower court's holding of validity when it, the Court of Appeals, used the words "any reasonable doubt will be resolved against the party alleging the invalidity of a patent." (Petition pp. 2, 9)

This asserted justification for seeking certiorari fails for several reasons. One reason is that, contrary to Bethlehem's assertion, undisputed prior publications and patents were not the sole factors used to determine validity. Bethlehem did use documentary evidence as a part of its attack upon validity but it admitted through its expert that no one prior art publication revealed the structure of any one of the claims in issue. (R. 525, 526) As Bethlehem admits in its Petition (p. 7) it relied upon several witnesses to explain "its concept" of various matters relating to validity.

The plaintiff through his own testimony, the testimony of a naval architect, and cross-examination of Bethlehem's witnesses showed how the plaintiff had a lifetime of experience in building marine structures (R. 47-59), the problems in the design of offshore drilling structures (R. 60-62), the unsuccessful attempts to solve these problems prior to the plaintiff's application for the patent in suit (R. 60-63, 105-112, 243-248), the differences between the prior art and the claims of the patent in suit, how the plaintiff (after filing his patent application but before the issuance of the patent in suit) submitted various documents to Bethlehem disclosing his invention and asking if Bethlehem would be interested in obtaining rights under his patent application, how Bethlehem declined and returned the docu-

ments to the plaintiff but unknown to and unauthorized by the plaintiff kept copies of these documents (R. 23, 26, 29, 64-66, 94), how Bethlehem in 1954 built a mobile offshore drilling structure known as "Mr. Gus I" which did not infringe the patent in suit as it operated on a different principle (R. 113-116, 155, 437-439), how Bethlehem unblushingly announced to the world at the time of the launching of Mr. Gus I that Mr. Gus I was "the result of a development based on the best scientific and engineering knowledge available. Several hundreds of thousands of dollars have been spent on basic research and design." (Pltf.'s Ex. 10-K at pages 3, 5, and 7, R. 39, 422-429, 432, 477-479), how there was difficulty in the basic design of Mr. Gus I from its maiden voyage until it finally tilted and turned over in about thirty feet of water in the Gulf of Mexico (R. 23, 27-29, 440), how Mr. Gus II was designed (R. 243, 249, 250) and because of limitations in the design of Mr. Gus I it was not duplicated in Mr. Gus II (R. 28, 29), and how Bethlehem was aware of the patent in suit when it constructed Mr. Gus II (R. 469). The history of this offshore art is recited by the trial court in its findings of fact and by the Court of Appeals in its decision. (R. 603-608, 618, 323 F. 2d 945, 946)

Credibility of witnesses and the meaning of certain publications relied upon by Bethlehem were at issue. For example, Bethlehem introduced much of its prior-art testimony through Mr. Nedderman who had had very little experience with offshore structures — having contributed to the design of only two. One of these (Trans Gulf 10) fell over into the water like Mr. Gus I — Bethlehem's earlier effort. **(R. 520, 521)**

Nedderman was asked what prior art he considered to be the most pertinent to claim 1 and what the most pertinent to claim 10. After taking ample time to answer, he concluded that Patent No. 2,603,068 to Wilson (Wilson 068)

and the British Patent No. 580 (British 580) were the closest of the prior art to claim 1 and they were both of equal pertinence. He next concluded that the Hansen patent No. 2,430,914 by itself was the most pertinent to claim 10. (Tr. 526-527, 532)

After the evening recess Neddermeyer twice changed his testimony on this point. He first changed it to say that British 580 was not only one of the two most perfinent patents to claim 1 but that it was also one of the two most pertiinent patents to claim 10 and that it was of equal pertinency with Wilson 068 to claim 1 and Hansen to claim 10. Later he changed his testimony again to say that Wilson 068 alone was most pertinent to claim 1. (Tr. 541, 542, 548, 558)

Christenson, the plaintiff's witness, explained how Wilson 068 will not function in the manner described in Wilson 068, how the proposed structure of a Russian reference would not function, and that the most pertinent prior art was considered by the patent office before it issued the Samuelson patent. (R. 585-588, 591)

The foregoing and other testimony of witnesses clearly reveals that documents alone were not the basis of the determination of the patent's validity and so the condition precedent upon which Bethlehem asserts it is erroneous to apply the "beyond a reasonable doubt" test fails.

Pertinent to this case are Mr. Justice Cardozo's statements in *Radio Corporation of America* v. *Radio Engineering Laboratories, Inc.*, 293 U.S. 1, 7, 79 L. Ed. 163, 167:

> ". . . A patent regularly issued and even more obviously a patent issued after a hearing of all the rival claimants, is presumed to be valid until the presumption has been overcome by convincing evidence of error. The force of that presumption has found varying ex-

> pression in this and other courts. Sometimes it is said that in a suit for infringement, when the defense is a prior invention, 'the burden of proof to make good this defense' is 'upon the party setting it up', and 'every reasonable doubt should be resolved against him'. (Citing cases.) Again it is said that 'the presumption of the validity of the patent is such that the defense of invention by another must be established by the clearest proof — perhaps beyond reasonable doubt'. (Citing cases.) The context suggests that in these and like phrases the courts were not defining a standard in terms of scientific accuracy or literal precision, but were offering counsel and suggestion to guide the course of judgment. Through all the verbal variances, however, there runs this common core of thought and truth, that one otherwise an infringer who assails the validity of a patent fair upon it face bears a heavy burden of persuasion, and fails unless his evidence has more than a dubious preponderance . . ." (Citing cases.)

Bethlehem does not deny that the "reasonable doubt" test applies to disputed issues of fact on which the determination of validity must be made and there is no showing that the "'reasonable doubt" rule was applied in this case other than to disputed facts for in affirming validity the Court of Appeals held:

> ". . . No prior invention disclosed the same combination of devices as the claims at issue in the Samuelson patent, and it is not at all clear that the entire invention would have been obvious to a person having ordinary skill in the art." (323 F. 2d 947)

This is the test of 35 U.S.C. § 103 which statute, Bethlehem admits (Petition, p. 19) is the test to be applied in determining if the patent in suit is valid.

In numerous cases where the determination of validity involved questions of fact the Courts of Appeals have stated, in language similar to that used by the Court of Appeals here, that every reasonable doubt should be resolved against the defendant.[3]

It is also worthy of note that the trial court, which the the Court of Appeals affirmed on the question of validity, did not mention a burden of reasonable doubt. It held the plaintiff valid because, "Bethlehem has failed to overcome the presumption of validity . . ." (R. 610).

Surely this case does not meet the qualification for granting writ of certiorari as set forth by Mr. Justice Taft in *Layne & Bowler Corporation* v. *Western Well Works*, 261 U.S. 387, 393, 67 L. Ed. 712, 714, that this Court:

> ". . . be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeals."

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[3] Lorenz v. F. W. Woolworth Co. (2nd Cir. 1962) 305 F. 2d 102, 105; Crosley Corp. v. Westinghouse Electric & Mfg. Co. (3rd Cir. 1945) 152 F. 2d 895, 904; Kraft Foods Co. v. Walther Dairy Products (7th Cir. 1956) 234 F. 2d 279, 282, cert. den. 352 U.S. 926, 1 L. Ed. 2d 161; Ezee Stone Cutter Mfg. Co. v. Southwest Industrial Products (8th Cir. 1958) 262 F. 2d 183, 188; G. H. Packwood Mfg. Co. v. St. Louis Janitor Supply Co. (8th Cir. 1940) 115 F. 2d 958, 964; Strong-Scott Mfg. Co. v. Weller (8th Cir. 1940) 112 F. 2d 389, 394; Donner v. Sheer Pharmacal Corp. (8th Cir. 1933) 64 F. 2d 217, 221, cert. den. 290 U.S. 658, 78 L. Ed. 570; Moon v. Cabot Shops, Inc. (9th Cir. 1959) 270 F. 2d 539, 541, cert. den. 361 U.S. 965, 4 L. Ed. 2d 546; Patterson-Ballagh Corp. v. Moss (9th Cir. 1953) 201 F. 2d 403, 406; Oxnard Canners v. Bradley (9th Cir. 1952) 194 F. 2d 655, 658 cert. den. 343 U.S. 978, 96 L. Ed. 1370.

To the same effect are *N.L.R.B.* v. *Pittsburgh S.S. Co.*, 340 U.S. 498, 502, 95 L. Ed 479, 482; *Rice* v. *Sioux City Cemetery*, 349 U.S. 70, 79, 99 L. Ed. 897, 904; *Keller* v. *Adams-Campbell Co.*, 264 U.S. 314, 319, 68 L. Ed. 705, 708.

It is noted that in its petition for rehearing to the Court of Appeals Bethlehem did not question the Court's affirmance of validity and in the footnote to page 1 of that petition Bethlehem stated:

> "In confining this Petition for Rehearing to the infringement issue, appellee is following the better practice of confining its scope to matters believed to have been overlooked or misapprehended by the Court."

At that time Bethlehem apparently did not consider that the Court of Appeals had "overlooked or misapprehended" anything with respect to validity.[4]

There Is No Conflict Between The Decision In This Case And Decisions Of This Court And Other Courts Of Appeals With Respect To The Holding Of Infringement By The Court Of Appeals For the Fifth Circuit.

Bethlehem's whole premise, which is erroneous, is that the Court of Appeals based its decision of infringement upon conflicting testimony and asserts that the Court of Appeals therefore could not reverse the finding of non-infringement without applying the clearly erroneous rule. Bethlehem's difficulty is that the Court of Appeals did not base its opinion of infringement on conflicting testimony but instead based it upon stipulations and admissions. (323 F. 2d 950, 951)

[4] It is believed that no reply is needed to Bethlehem's accusation of bias on the part of the Court of Appeals for the Fifth Circuit. (Petition p. 20)

Graver Mfg. Co. v. *Linde Co.*, 339 U.S. 605, 94 L. Ed. 1097, does not stand for the proposition that in all instances a determination of infringement, including a determination of equivalence, is a question of fact and Bethlehem apparently does not so contend for in the second of its "Questions Presented" (Petition p. 3) and in its "Reason 3" (Petition p. 21) Bethlehem urges the existence of conflicting testimony. As shown above no conflict existed on the controlling facts.

In *Sanitary Refrigerator Co.* v. *Winters*, 280 U.S. 30, 36, 74 L. Ed. 147, 153, this Court held:

> ". . . Furthermore, upon the undisputed evidence the question of infringement resolves itself in each case into one of law, depending upon a comparison between the structure disclosed on the face of the patent and the device shown in the Dent latch, and the correct application thereto of the rule of equivalency. Compare Singer Mfg. Co. v. Cramer, 192 U.S. 265, 275, 48 L. Ed. 437, 443, 24 Sup. Ct. Rep. 291."

The Fifth Circuit is only one of several circuits which has held since the *Graver* case that where there is no dispute as to the controlling facts upon which infringement is to be determined the Court of Appeals can review the decision of the trial court free of the clearly erroneous rule.[5] There is no conflict.

In view of the stipulations of the parties previously referred to herein a more perfect situation for review by a

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[5] Plax Corp. v. Precision Extruders, Inc. (3rd Cir. 1957) 239 F. 2d 792, 795; Kiwi Coders Corp. v. Aero Tool & Die Works (7th Cir. 1957) 250 F. 2d 562, 568; Plax Corp. v. Elmer E. Mills Corp. (7th Cir. 1953) 204 F. 2d 302, 308; Del Francia v. Stanthony Corp. (9th Cir. 1960) 278 F. 2d 745, 748; Hansen v. Colliver (9th Cir. 1960) 282 F. 2d 66, 69; Kwikset Locks, Inc. v. Hillgren (9th Cir. 1954) 210 F. 2d 483, 488, 489, cert. den. 347 U.S. 989, 98 L. Ed. 1123, and 348 U.S. 855; 99 L. Ed. 673, reh. den. 348 U.S. 852, 99 L. Ed. 671; Kemart Corp. v. Printing Arts Research Laboratories (9th Cir. 1953) 201 F. 2d 624, 627.

Court of Appeals of the lower court's decision on infringement can hardly be imagined. However, Bethlehem seems to assert that for the Court of Appeals to have concluded that certain structure and operation stipulated to exist in Mr. Gus II are the equivalent of certain structure and operation of claims 1 and 10 of the patent in suit there must also be a stipulation between the parties that these matters are equivalents. Such an occurrence in litigation cannot be expected and was not present in the cases cited in the footnote to the previous paragraph. If Bethlehem's contention were correct the rule of those cases could never be applied.

CONCLUSION

WHEREFORE, premises considered, Respondent prays that the petition for certiorari be denied.

Respectfully submitted,

JAMES F. WEILER
JEFFERSON D. GILLER
CLEVE BACHMAN

Attorneys for Respondent

Mobile Units, Tenders, And Self-Contained Platforms

Mobile Units

OWNER	NAME	WATER DEPTH	PRESENT STATUS
Abut Dhabi Marine Areas Limited	Adma Enterprise	100'	Drilling Zakum—1, 50 miles SE Umm Shaif field Persian Gulf
Barge Facilities, Inc. Twin-hull submersible 217' x 100'	S-66	100'	Drilling for CALCO, Block 22, South Marsh Island
Barnwell Offshore, Inc. Self-elevating 176' x 176' x 152' with three 175' legs	"Mister Cap"	to 125'	Drilling for Shell Oil Co., Block 189, E. Cameron Area
Barnwell Offshore, Inc.	Rig No. 2		Working over wells for Continental Oil Co., Block 194, Well A-6, W. Cameron Area
Blue Water Drilling Corp. Submersible	Rig No. 1	340'	Block 110 Grand Isle Area, Shell Oil Co.
Blue Water Drilling Corp. Floating	Rig No. 2	to 800'	Under Const. in Calif.
The California Company Submersible 11' x 90' x 156' with four 3' x 10' x 35' pontoons	S 45	25'	Drilling for CALCO, Ship Shoal, Block 108, Rowan Drilling Co., contractors
The California Company Submersible 12' x 90' x 190', with four 4' x 24' x 50' pontoons	S 55	45'	Drilling for Noble Dig. Co., Block 30, West Delta Area
Coral Drilling Company Submersible 180' x 151' x 104' with four bottles	"Mr. Arthur"		Drilling for Calif. Co. Block 41, Main Pass Area
Delta Marine Drilling Co. Submersible	"Chris Zeppa"		Block 54, Vermilion Area
Dixilyn Corp. Self-elevating 194' x 152' overall. Three 205' legs	"Julie Ann"	to 143'	Drilling for Humble Oil & Refining, Co., Block 386, West Cameron Area
Dixilyn Corp. Self-elevating Three 376-ft. legs		250'	Drilling for Humble Oil, Block 73, West Delta Area
Global Marine Exploration Co. Floating vessel	Cuss 1		Drilling off Santa Barbara, for Standard Oil of Calif.
Global Marine Exploration Co. Floating vessel—Self propelled	Glomar II		Drilling off San Francisco, for Shell Oil Co.
Global Marine Exploration Co. Floating vessel—Self propelled	Glomar III		Drilling for Shell Oil Co. Gulf of Mexico
Global Marine Exploration Co. Floating vessel—Self propelled	Glomar IV		Drilling for Continental Oil Co., Gulf of Mexico
Global Marine Exploration Co. Floating Vessel—LSM	Western Explorer		En route to Surinam for Gulf States Land and Industries Co.
Global Marine Exploration Co. Floating Vessel—LSM	Rincon		Idle, Long Beach Calif.
Gulf Marine Drilling, Inc. Submersible	Rig No. 1	35	Drilling for Gulf Oil Corp., Block 24, West Delta, Well No. 11
Hyperion Constructors Self-elevating	George F. Ferris	200'	Drilling for Union Oil Co. of Calif., Santa Barbara Area
Kerr-McGee Oil Ind., Inc. Submersible 13' x 54' x 160' with two 13' x 11' x 110' pontoons	Rig 40	to 20	Drilling for Kerr-McGee, Block 28, Ship Shoal Area
Kerr-McGee Oil Ind., Inc. Submersible 13½' x 72' x 140' with two 13½' x 13½' x 140' pontoons	Rig 44	to 40	Drilling for Kerr-McGee Block 16, East Cameron Area
Kerr-McGee Oil Ind., Inc. Submersible 142' x 69' x 13'6", with two 10' x 11' x 146' pontoons	Rig 45		Drilling for Kerr-McGee & Phillips, Block 21, Breton Sound Area
Kerr-McGee Oil Ind., Inc. Submersible	Rig 46	to 70	Drilling Gulf Oil Corp. Block 21, South Timbalier Area
Kerr-McGee Oil Ind., Inc. Submersible	Rig 47	to 70'	Drilling for Gulf Oil Corp. Block 21, South Timbalier
Kerr-McGee Oil Ind., Inc. Submersible	Rig 54	to 175'	Drilling for Mobil, Block 62, West Delta Area
Long Point Gas & Oil Ltd.	Translake No. 1	35	Drilling for Self, Lake Erie
Long Point Gas & Oil Ltd.	Translake No. 2	54'	Drilling for Self, Lake Erie
Louisiana Delta Offshore Corp. Submersible 180' x 151' x 12'	Drill Barge Louisiana	to 65'	Drilling in Block 30, West Delta Area
Louisiana Delta Offshore Corp. Submersible 156' x 90' x 11'	Drill Barge Delta	to 25	Drilling for International Drilling Co., Persian Gulf
Midcon Oil & Gas Co., Ltd.	Midcon No. 1	90'	Not drilling
Movible Offshore Co. Submersible 201' x 211' x 110'	Movible No. 2	to 70	Drilling for Shell Oil Co. Block 30, West Delta Area
Movible Offshore Co. Submersible 200' x 144' x 67'	Movible No. 3	to 40'	Drilling for Shell Oil Co. Block 27, South Pass Area
Movible Offshore Co. Self-Propelled Drilling Tender	Rig No. 4		Drilling for Mobil Oil Co. Block 126, Eugene Island Area
Ocean Drilling & Exploration Company Submersible 200' x 300' x 98'	"El Dorado"	to 70'	Drilling for Shell Oil Co. Block 7, South Marsh Island
Ocean Drilling & Exploration Company Submersible 120' x 180' x 30'	"St. Louis"	30'	Drilling for Superior Oil, Block 27, Vermilion Area
Ocean Drilling & Exploration Company Floating drilling Island	Ocean Driller"	to 600'	Drilling for Texaco Block 206, Eugene Island Area
Ocean Drilling & Exploration Company	Ocean Explorer"	to 600'	Under Construction Avondale Shipyards, Del. Sept. 1, 1964
The Offshore Company Self-Contained Platform 110' x 150'	Rig 12		Drilling for Texaco South Pass, Block 37
The Offshore Company Self-Contained Platform 145' x 90'	Rig 25		Docked at Bayou Boeuf, La.
The Offshore Company Floating drilling vessel 252' x 46' x 16' draft	Offshore C 1	200'	Laid up for winter
The Offshore Company Self-elevating 133½' x 117' x 220' with fourteen 6' dia. caissons	Mobile Unit No. 52	100'	Drilling for Amoseas, Nigeria, West Africa
The Offshore Company Self-elevating 12' x 74' x 200' with four 6' dia. caissons	Mobile Unit No. 53	35'	Drilling for Union Oil Co. of Calif., Block 26, Vermilion Area
The Offshore Company Self-elevating 200' x 104' x 15' with eight 12' dia. towers	Mobile Unit No. 54	125'	Drilling for Shell Block 193, Vermillion Area
The Offshore Company Self-elevating 200' x 104' x 15' with eight 12' dia. towers	Mobile Unit No. 55	180'	Drilling for Abu Dhabi Marine Areas, Persian Gulf
The Offshore Company Self-elevating 188' x 106' x 13' with four 10' dia. caissons	Mobile Unit No. 57	100'	Leased to Texaco Trinidad Gulf of Paria
The Offshore Company Self-elevating 97½' x 80' x 12' with three 6' dia. caissons	Mobile Unit No. 58	100'	Docked at Bayou Boeuf, La.
The Offshore Company Self-elevating 97½' x 80' x 12' with three 6' dia. caissons	Mobile Unit No. 59	120'	Drilling for SPAFE Port Gentil, Republic of Gabon Africa
The Offshore Company Self-elevating 108' x 101' x 12' with three 6' dia. caissons	Mobile Unit No. 60	120'	Drilling for Venezuelan Sun Oil Company in Lake Maracaibo, Venezuela
The Offshore Company Floating drilling ship, 320' x 70' x 25'	Discoverer		Drilling for Mobil Oil Co. Block 240, So. Timbalier Area
Pan American International Oil Co. Self-elevating 200' x 104' with 8-12' dia. towers	Panitoil 2		Drilling for Kuwait Shell Petroleum Development Co., Ltd., operated by Southeastern Drlg. Co.
Penrod Drilling Company Submersible 196' x 134'	Rig 50	46'	Drilling for Mobil Oil Co., Block 126, Eugene Island Area
Penrod Drilling Company Submersible 150' x 190'	Rig 51	to 60'	Drilling for The California Co., Block 23, Bay Marchand Area
Penrod Drilling Company Submersible 198' x 174'	Rig 52	100	Drilling for Shell Oil Company in Galveston Bucaneer Area, Offshore Texas
Rimrock Tidelands, Inc. Submersible	"Rimr		
Rimrock Tidelands, Inc. Submersible 160' x 190'	Barge		
Sea Drilling Corp Submersible	Sea		
Sea Drilling Corp Submersible	Sea		
Seacat-Zapata Offshore Co. Floating Drill Barge	"Nola		
The Shell Co. of Qatar, Ltd.	Seathe		
Southeastern Drilling Corp. Submersible 11' x 90' x 156' with four pontoons	Rig 2		
Tidal, Inc. Self-elevating Deck 258' x 104', pad 200' x 180' with four 10' dia. columns	Mr		
Western Offshore Drilling & Exploration Co. Floating drill barge	M/V		
Western Offshore Drilling & Exploration Co. Floating drill barge 254' x 68'	West Offsh		
Western Offshore Drilling & Exploration Co.	Weste shore		
Zapata Off-Shore Company Self-elevating, 194' x 152' overall. Three 173' legs	"Vine roon		
Zapata Off-Shore Company Self-elevating 20' x 80' x 140', with three 152' triangular legs	"Scor		
Zapata Off Shore Co. Floating drill barge	No		
Zapata Offshore Co. Floating drill barge	"Side		
Zapata Off-Shore Co. Self-elevating Three 376-ft. legs	Mar		

Drilling

Arabian American Oil Co.	Aram Tende	
The California Company Converted LST, 328' x 50'	S-21	
The California Company Converted LST, 328' x 50'	S-22	
The California Company Converted LST, 328' x 50'	S-23	
The California Company LST, 328' x 50'	S-24	
The California Company LST, 328' x 50'	S-25	
The California Company LST, 328' x 50'	S-26	
CATC Group New tender, 260' x 54'	Ernie	
CATC Group New tender, 260' x 54'	Jack Cleve	
Delta Marine Drilling Co. Converted LST, 326' x 50'	Jose Zepo	
Gulf Oil Corporation x 60'	Pe	

Units, Tenders, ntained Platforms

lobile Units

NAME	WATER DEPTH	PRESENT STATUS
Sema Enterprise	100'	Drilling Zatum—1, 50 miles SE Umm Shaif field, Persian Gulf
5-46	100'	Drilling for CALCO, Block 22, South Marsh Island
Mister Cap"	to 125'	Drilling for Shell Oil Co., Block 189, E. Cameron Area
Rig No. 2		Working over wells for Continental Oil Co., Block 194, Well A-6, W. Cameron Area.
Rig No. 1	340'	Block 110 Grand Isle Area, Shell Oil Co.
Rig No. 2	to 800'	Under Const. in Calif.
45	25'	Drilling for CALCO, Ship Shoal, Block 108, Rowan Drilling Co., contractors
55	45'	Drilling for Noble Dlg. Co., Block 30, West Delta Area
Mr. Arthur"		Drilling for Calif. Co. Block 41, Main Pass Area
Chris eppa"		Block 54, Vermilion Area
Julie Ann"	to 143'	Drilling for Humble Oil & Refining Co., Block 386, West Cameron Area
	250'	Drilling for Humble Oil, Block 73, West Delta Area
uss 1		Drilling off Santa Barbara, for Standard Oil of Calif.
iomar II		Drilling off San Francisco, for Shell Oil Co.
iomar III		Drilling for Shell Oil Co., Gulf of Mexico
iomar IV		Drilling for Continental Oil Co., Gulf of Mexico
iomar V		Drilling off Libya, for At-

OWNER	NAME	WATER DEPTH	PRESENT STATUS
Global Marine Exploration Co. Floating Vessel—LSM	Western Explorer		En route to Surinam for Gulf States Land and Industries Co.
Global Marine Exploration Co. Floating Vessel—LSM	Rincon		Idle, Long Beach, Calif.
Gulf Marine Drilling, Inc. Submersible	Rig No. 1	35	Drilling for Gulf Oil Corp., Block 24, West Delta, Well No. 11
Hyperion Constructors Self-elevating	"George F Ferris"	200'	Drilling for Union Oil Co. of Calif., Santa Barbara Area
Kerr-McGee Oil Ind., Inc. Submersible 13' x 54' x 160' with two 13' x 14' x 110' pontoons	Rig 40	to 20'	Drilling for Kerr-McGee, Block 28, Ship Shoal Area
Kerr-McGee Oil Ind., Inc. Submersible 13½' x 72' x 140' with two 13½' x 13½' x 140' pontoons	Rig 44	to 40'	Drilling for Kerr-McGee, Block 16, East Cameron Area
Kerr-McGee Oil Ind., Inc. Submersible 142' x 69' x 13'6", with two 10' x 11' x 146' pontoons	Rig 45		Drilling for Kerr-McGee & Phillips, Block 21, Breton Sound Area
Kerr-McGee Oil Ind., Inc. Submersible	Rig 46	to 70'	Drilling Gulf Oil Corp. Block 21, South Timbalier Area
Kerr-McGee Oil Ind., Inc. Submersible	Rig 47	to 70'	Drilling for Gulf Oil Corp. Block 21, South Timbalier
Kerr-McGee Oil Ind., Inc. Submersible	Rig 54	to 175'	Drilling for Mobil, Block 62, West Delta Area
Long Point Gas & Oil Ltd.	Translake No. 1	35	Drilling for Self, Lake Erie
Long Point Gas & Oil Ltd.	Translake No. 2	54	Drilling for Self, Lake Erie
Louisiana-Delta Offshore Corp. Submersible 180' x 151' x 12'	Drill Barge Louisiana	to 65'	Drilling in Block 30, West Delta Area
Louisiana-Delta Offshore Corp. Submersible 156' x 90' x 11'	Drill Barge Delta	to 25'	Drilling for International Drilling Co., Persian Gulf
Midcon Oil & Gas Co., Ltd.	Midcon No. 1	90-	Not drilling
Movible Offshore Co. Submersible 201' x 211' x 110'	"Movible No. 2"	to 70'	Drilling for Shell Oil Co., Block 30, West Delta Area
Movible Offshore Co. Submersible 200' x 146' x 67'	"Movible No. 3"	to 40'	Drilling for Shell Oil Co., Block 27, South Pass Area
Movible Offshore Co. Self-Propelled Drilling Tender	Rig No. 4		Drilling for Mobil Oil Co., Block 128, Eugene Island Area
Ocean Drilling & Exploration Company Submersible 200' x 300' x 98'	"El Dorado"	to 70'	Drilling for Shell Oil Co., Block 7, South Marsh Island
Ocean Drilling & Exploration Company	"M. Charlie"	40	Drilling for Gulf Oil Corp., Block 57, West

OWNER	NAME	WATER DEPTH	PRESENT STATUS
Ocean Drilling & Exploration Company Submersible 120' x 180' x 50'	"St. Louis"	30'	Drilling for Superior Oil, Block 27, Vermilion Area
Ocean Drilling & Exploration Company Floating drilling island	Ocean Driller"	to 600'	Drilling for Texaco, Block 206, Eugene Island Area
Ocean Drilling & Exploration Company	"Ocean Explorer"	to 600'	Under Construction Avondale Shipyards, Del. Sept. 1, 1964
The Offshore Company Self-Contained Platform 110' x 150'	Rig 12		Drilling for Texaco, South Pass, Block 37
The Offshore Company Self-Contained Platform 155' x 90'	Rig 25		Docked at Bayou Boeuf, La.
The Offshore Company Floating drilling vessel 252' x 46' x 16' draft	Offshore C-1	200'	Laid up for winter
The Offshore Company Self-elevating 133/3' x 117' x 220' with fourteen 6' dia. caissons	Mobile Unit No. 52	100'	Drilling for Amoseas, Nigeria, West Africa
The Offshore Company Submersible 12' x 74' x 200' with four 6' dia. caissons	Mobile Unit No. 53	35'	Drilling for Union Oil Co. of Calif., Block 26, Vermilion Area
The Offshore Company Self-elevating 200' x 104' x 15' with eight 12' dia. towers	Mobile Unit No 54	125'	Drilling for Shell, Block 193, Vermillion Area
The Offshore Company Self-elevating 200' x 104' x 15' with eight 12' dia. towers	Mobile Unit No. 55	180'	Drilling for Abu Dhabi Marine Areas, Persian Gulf
The Offshore Company Self-elevating 188' x 106' x 13' with four 10' dia. caissons	Mobile Unit No. 57	100'	Leased to Texaco-Trinidad Gulf of Paria
The Offshore Company Self-elevating 97½' x 80' x 12' with three 6' dia. caissons	Mobile Unit No. 58	100'	Docked at Bayou Boeuf, La.
The Offshore Company Self-elevating 97½' x 80' x 12' with three 6' dia. caissons	Mobile Unit No. 59	120'	Drilling for SPAFE Port Gentil, Republic of Gabon Africa
The Offshore Company Self-elevating 108' x 101' x 12' with three 6' dia. caissons	Mobile Unit No. 60	120'	Drilling for Venezuelan Sun Oil Company in Lake Maracaibo, Venezuela
The Offshore Company Floating drilling ship, 320' x 70' x 25'	Discoverer		Drilling for Mobil Oil Co. Block 240, So. Timbalier Area
Pan American International Oil Co. Self-elevating 200' x 104' with 8'-12' dia. towers	Panitoil 2		Drilling for Kuwait Shell Petroleum Development Co., Ltd., operated by Southeastern Drlg. Co.
Penrod Drilling Company Submersible 196' x 134'	Rig 50	44'	Drilling for Mobil Oil Co., Block 126, Eugene Island Area
Penrod Drilling Company Submersible 150' x 190'	Rig 51	to 60'	Drilling for The California Co., Block 23, Bay Marchand
Penrod Drilling Company Submersible 198' x 174'	Rig 52	100	Drilling for Shell Oil Company in Galveston Bucaneer Area, Offshore Texas
Place Gas & Oil Co., Ltd.	Barge 2		Drilling for Self, Lake Erie

OWNER	NAME	WATER DEPTH	PRESENT STATUS
Rimrock Tidelands, Inc. Submersible	"Rimtide"	35'	West Delta Area, Block 27
Rimrock Tidelands, Inc. Submersible 160' x 190'	Barge A	to 70'	Block 27, West Cameron Area
Sea Drilling Corp. Submersible	Seadrill 2"	30'	Block 17, W. Cameron Area
Sea Drilling Corp. Submersible	"Seadrill 3"	30'	Block 1, Bay Marchand Area
Seacat-Zapata Offshore Co. Floating Drill Barge	"Nola 3"		Persian Gulf, Kuwait, drilling for Shell
The Shell Co. of Qatar, Ltd.	Seashell	100	Drilling for Shell off Qatar
Southeastern Drilling Corp. Submersible 11' x 90' x 156' with four pontoons	Rig 22	25'	Drilling for Calco, Block 107, Ship Shoal Area
Tidal, Inc. Self-elevating Deck 258' x 104', pad 200' x 180' with four 10' dia. columns	"Mr. Gus II"	150'	Drilling for Continental Oil Co., Block 32, Grand Isle Area
Western Offshore Drilling & Exploration Co. Floating drill barge	M/V Torry		Singapore Harbor
Western Offshore Drilling & Exploration Co. Floating drill barge 254' x 68'	"Western Offshore No. 1"		Drilling offshore Santa Barbara, Calif. for Phillips Petroleum
Western Offshore Drilling & Exploration Co.	Western Offshore No. II		Drilling in Cook Inlet, Alaska for Pan-American et al
Zapata Off-Shore Company Self-elevating, 194' x 152' overall. Three 173' legs	"Vinegaroon"	to 105'	Drilling off Trinidad, W.I.
Zapata Off-Shore Company Self-elevating, 20' x 80' x 140', with three 152' triangular legs	"Scorpion"	80	Drilling in Block 188, Eugene Island Area
Zapata Off-Shore Co. Floating drill barge	Nola 1		Levingston Shipyard, Orange, Texas
Zapata Offshore Co. Floating drill barge	"Sidewinder"		On location in Borneo
Zapata Off-Shore Co. Self-elevating Three 376-ft. legs	"Mavrick"	250'	UNDER CONSTRUCTION

Drilling Tenders

Arabian American Oil Co.	Aramco Drill Tender—1		Drilling in Persian Gulf
The California Company Converted LST, 328' x 50'	S-21	50'	Idle
The California Company Converted LST, 328' x 50'	S-22	49'	Idle
The California Company Converted LST, 328' x 50'	S-23		Mothballed
The California Company LST, 328' x 50'	S-24	46'	Block 41, Main Pass Area, Noble Drlg. Co.
The California Company LST, 328' x 50'	S-25	48	Bay Marchand, La., Noble Drilling Co.
The California Company LST, 328' x 50'	S-26	46'	Idle
CATC Group New tender, 260' x 54'	"Ernie Miller"	50'	Moved to West Delta Block 58A Platform
CATC Group New tender, 260' x 54'	"Jack Cleverley"	122	West Delta Area, Block 70, "E" Platform
Delta Marine Drilling Co. Converted LST, 326' x 50'	"Joseph Zeppa"		Block 46, Grand Isle Area, Humble Oil & Refining Co.
Gulf Oil Corporation New tender, 272' x 60'	"Pelican"		Block 152, S. Timbalier Area, self-

			sian Gulf
Barge Facilities, Inc. Twin-hull submersible 217' x 180'	S-66	180'	Drilling for CALCO Block 22, South Marsh Island
Barnwell Offshore, Inc. Self-elevating 176' x 176' x 152' with three 175' legs	"Mister Cap"	to 125'	Drilling for Shell Oil Co., Block 189, E. Cameron Area
Barnwell Offshore, Inc.	Rig No. 2		Working over wells for Continental Oil Co., Block 194, Well A-6, W. Cameron Area
Blue Water Drilling Corp. Submersible	Rig No. 1	340'	Block 110 Grand Isle Area, Shell Oil Co.
Blue Water Drilling Corp. Floating	Rig No. 2	to 800'	Under Const. in Calif.
The California Company Submersible 11' x 90' x 156' with four 3' x 10' x 35' pontoons	S-45	25'	Drilling for CALCO, Ship Shoal, Block 108, Rowan Drilling Co., contractors
The California Company Submersible 12' x 90' x 190', with four 4' x 24' x 50' pontoons	S-55	45'	Drilling for Noble Dig. Co., Block 30, West Delta Area
Coral Drilling Company Submersible 180' x 151' x 104' with four bottles	"Mr. Arthur"		Drilling for Calif. Co., Block 41, Main Pass Area
Delta Marine Drilling Co. Submersible	"Chris Zeppa"		Block 54, Vermilion Area
Dixilyn Corp. Self-elevating 194' x 152' overall, Three 205' legs	"Julie Ann"	to 143'	Drilling for Humble Oil & Refining Co., Block 386, West Cameron Area
Dixilyn Corp. Self-elevating Three 376-ft. legs		250'	Drilling for Humble Oil, Block 73, West Delta Area
Global Marine Exploration Co. Floating vessel	Cuss 1		Drilling off Santa Barbara, for Standard Oil of Calif.
Global Marine Exploration Co. Floating vessel—Self propelled	Glomar II		Drilling off San Francisco, for Shell Oil Co.
Global Marine Exploration Co. Floating vessel—Self propelled	Glomar III		Drilling for Shell Oil Co., Gulf of Mexico
Global Marine Exploration Co. Floating vessel—Self propelled	Glomar IV		Drilling for Continental Oil Co., Gulf of Mexico
Global Marine Exploration Co. Floating vessel—Self propelled	Glomar V		Drilling off Libya, for Atlantic
Global Marine Exploration Co. Floating vessel—Self propelled	Submarex		En Route to California.
Global Marine Exploration Co. Exploration vessel—Self propelled	La Ciencia		Idle—Long Beach, California.

Kerr-McGee Oil Ind., Inc. Submersible 13' x 54' x 160' with two 13' x 14' x 110' pontoons	Rig 40	to 30'	Drilling for Kerr-McGee, Block 28, Ship Shoal Area
Kerr-McGee Oil Ind., Inc. Submersible 13½' x 72' x 140' with two 13½' x 13½' x 140' pontoons	Rig 44	to 40'	Drilling for Kerr-McGee, Block 16, East Cameron Area
Kerr-McGee Oil Ind., Inc. Submersible 142' x 69' x 13'6" with two 10' x 11' x 146' pontoons	Rig 45		Drilling for Kerr-McGee & Phillips, Block 21 "Breton Sound Area
Kerr-McGee Oil Ind., Inc. Submersible	Rig 46	to 70'	Drilling Gulf Oil Corp., Block 21, South Timbalier Area
Kerr-McGee Oil Ind., Inc. Submersible	Rig 47	to 70'	Drilling for Gulf Oil Corp., Block 21, South Timbalier
Kerr-McGee Oil Ind., Inc. Submersible	Rig 54	to 175'	Drilling for Mobil, Block 62, West Delta Area
Long Point Gas & Oil Ltd.	Translake No. 1	35'	Drilling for Self, Lake Erie
Long Point Gas & Oil Ltd.	Translake No. 2	54'	Drilling for Self, Lake Erie
Louisiana-Delta Offshore Corp., Submersible 180' x 151' x 12'	Drill Barge Louisiana	to 65'	Drilling in Block 30, West Delta Area
Louisiana-Delta Offshore Corp. Submersible 156' x 90' x 11'	Drill Barge Delta	to 25'	Drilling for International Drilling Co., Persian Gulf
Midcon Oil & Gas Co., Ltd.	Midcon No. 1	90'	Not drilling
Movible Offshore Co. Submersible 201' x 211' x 110'	"Movible No. 2"	to 70'	Drilling for Shell Oil Co., Block 30, West Delta Area
Movible Offshore Co. Submersible 200' x 146' x 67'	"Movible No. 3"	to 40'	Drilling for Shell Oil Co., Block 27, South Pass Area
Movible Offshore Co. Self-Propelled Drilling Tender	Rig No. 4		Drilling for Mobil Oil Co., Block 128, Eugene Island Area
Ocean Drilling & Exploration Company Submersible 200' x 300' x 98'	"El Dorado"	to 70'	Drilling for Shell Oil Co., Block 7, South Marsh Island
Ocean Drilling & Exploration Company Submersible 132' x 220' x 58'	"Mr. Charlie"	40'	Drilling for Gulf Oil Corp., Block 57, West Delta Area
Ocean Drilling & Exploration Company Submersible 120' x 180' x 49'	"John Hayward"	30'	Drilling for Odeco, et al, Block 12, South Pelto Area
Ocean Drilling & Exploration Company Submersible 200' x 300' x 93'	"Margaret"	to 60'	Drilling for Humble Oil, Block 34, South Timbalier Area

The Offshore Company Self-Contained Platform 145' x 90'	Rig 25		Docked at Bayou Boeuf, La.
The Offshore Company Floating drilling vessel 252' x 44' x 16' draft	Offshore C-1	200'	Laid up for winter
The Offshore Company Self-elevating 139½' x 117' x 220' with fourteen 6' dia. caissons	Mobile Unit No. 52	180'	Drilling for Amoseas, Nigeria, West Africa
The Offshore Company Submersible 12' x 74' x 200' with four 6' dia. caissons	Mobile Unit No. 53	35'	Drilling for Union Oil Co. of Calif., Block 24, Vermilion Area
The Offshore Company Self-elevating 200' x 104' x 15' with eight 12' dia. towers	Mobile Unit No. 54	125'	Drilling for Shell, Block 193, Vermillion Area
The Offshore Company Self-elevating 200' x 104' x 15' with eight 12' dia. towers	Mobile Unit No. 55	180'	Drilling for Abu Dhabi Marine Areas, Persian Gulf
The Offshore Company Self-elevating 188' x 104' x 13' with four 10' dia. caissons	Mobile Unit No. 57	300'	Leased to Texaco-Trinidad Gulf of Paria
The Offshore Company Self-elevating 97½' x 80' x 12' with three 6' dia. caissons	Mobile Unit No. 58	150'	Docked at Bayou Boeuf, La.
The Offshore Company Self-elevating 97½' x 80' x 12' with three 6' dia. caissons	Mobile Unit No. 59	120'	Drilling for SAFE for Gentil, Republic of Gabon Africa
The Offshore Company Self-elevating 108' x 101' x 12' with three 6' dia. caissons	Mobile Unit No. 60	120'	Drilling for Venezuelan Sun Oil Company in Lake Maracaibo, Venezuela
The Offshore Company Floating drilling ship 320' x 70' x 25'	Discoverer		Drilling for Mobil Oil Co., Block 240, So. Timbalier Area
Pan American International Oil Co. Self-elevating 200' x 104' with 8-12' dia. towers	Panitoll 2		Drilling for Kuwait Shell Petroleum Development Co., Ltd., operated by Southeastern Drlg. Co.
Penrod Drilling Company Submersible 196' x 134'	Rig 50	44'	Drilling for Mobil Oil Co., Block 126, Eugene Island, Area
Penrod Drilling Company Submersible 150' x 190'	Rig 51	to 60'	Drilling for The California Co., Block 23, Bay Marchand Area
Penrod Drilling Company Submersible 198' x 174'	Rig 52	100	Drilling for Shell Oil Company in Galveston, Bucaneer Area, Offshore Texas
Place Gas & Oil Co., Ltd.	Barge 2		Drilling for Self, Lake Erie
Place Gas & Oil Co., Ltd.	Barge 3		Drilling for Self, Lake Erie
Reading & Bates Offshore Drilling Company Self-elevating	"C. E. Thornton"	to 110'	Drilling for Pakistan Sun Oil, Karachi, W. Pakistan
Reading & Bates Offshore Drilling Company Floating Drilling Vessel	"Catamaran C. P. Baker"		Drilling for Pan American Petroleum Corp., Block 103, W. Delta Area
Reading & Bates Exploration Co. Self-elevating	"Mr. Louie"	to 120'	Drilling for Shell Oil Co., Block 160, So. Timbalier Area

Southeastern Drilling Corp. Submersible 11' x 90' x 156' with four pontoons	Rig	
Tidal, Inc. Self-elevating, Deck 258 x 104, pad 200' x 180' with four 10' dia. columns	M	
Western Offshore Drilling & Exploration Co. Floating drill barge	M/	
Western Offshore Drilling & Exploration Co. Floating drill barge 254' x 68'	W Offs	
Western Offshore Drilling & Exploration Co.	We shore	
Zapata Off Shore Company Self-elevating 194' x 152' overall Three 173' legs	"Vine roon	
Zapata Off Shore Company Self-elevating 20' x 80' x 140' with three 152' triangular legs	"Sco	
Zapata Off Shore Co. Floating drill barge	"N	
Zapata Offshore Co. Floating drill barge	"Side	
Zapata Off Shore Co. Self-elevating Three 376-ft legs	Mav	

Drilling

Arabian American Oil Co.	Aram Tenge	
The California Company Converted LST 328' x 50'	S 21	
The California Company Converted LST 328' x 50'	S 22	
The California Company Converted LST 328' x 50'	S 23	
The California Company LST 328' x 50'	S 24	
The California Company LST 328' x 50'	S 25	
The California Company LST 328' x 50'	S 26	
CATC Group New tender 260' x 54'	Erne	
CATC Group New tender 260' x 54'	Jan Cleve	
Delta Marine Drilling Co. Converted LST 326' x 50'	Jim Zepa	
Gulf Oil Corporation New tender 272' x 60'	Pel	
Humble Oil & Refining Co. Converted LST 328' x 50'	ST-1	
Humble Oil & Refining Co. Converted LST 328' x 50'	ST-2	
Humble Oil & Refining Co. Converted LST 328' x 50'	ST-4	
Humble Oil & Refining Co. Converted LST 328' x 50'	ST-5	
Humble Oil & Refining Co. Converted LST 328' x 50'	ST-7	

				Area
	100'	Drilling for CALCO Block 22, South Marsh Island	Kerr-McGee Oil Ind., Inc. Submersible 13' x 54' x 160' with two 13' x 14' x 110' pontoons	Rig 40 to 20' Drilling for Kerr-McGee, Block 28, Ship Shoal Area
ster-Cap	to 125'	Drilling for Shell Oil Co., Block 189, E. Cameron Area	Kerr-McGee Oil Ind., Inc. Submersible 13½' x 72' x 140' with two 13½' x 13½' x 140' pontoons	Rig 44 to 40 Drilling for Kerr-McGee, Block 16, East Cameron Area
No. 2		Working over wells for Continental Oil Co., Block 194, Well A-6, W. Cameron Area	Kerr-McGee Oil Ind., Inc. Submersible 142' x 69' x 13'6" with two 10' x 11' x 146' pontoons	Rig 45 Drilling for Kerr-McGee & Phillips, Block 21, Breton Sound Area
No. 1	340'	Block 110 Grand Isle Area, Shell Oil Co.	Kerr-McGee Oil Ind., Inc. Submersible	Rig 46 to 70 Drilling Gulf Oil Corp., Block 21, South Timbalier Area
No. 2	to 800'	Under Const. in Calif.	Kerr-McGee Oil Ind., Inc. Submersible	Rig 47 to 70 Drilling for Gulf Oil Corp., Block 21, South Timbalier
	25'	Drilling for CALCO, Ship Shoal, Block 108, Rowan Drilling Co., contractors	Kerr-McGee Oil Ind., Inc. Submersible	Rig 54 to 175 Drilling for Mobil, Block 62, West Delta Area
	45'	Drilling for Noble Drlg. Co., Block 30, West Delta Area.	Long Point Gas & Oil Ltd.	Translake No. 1 35 Drilling for Self, Lake Erie
Arthur"		Drilling for Calif. Co., Block 41, Main Pass Area	Long Point Gas & Oil Ltd.	Translake No. 2 54 Drilling for Self, Lake Erie
		Block 54, Vermilion Area	Louisiana-Delta Offshore Corp. Submersible 180' x 151' x 12'	Drill Barge Louisiana to 65' Drilling in Block 30, West Delta Area
e Ann	to 143'	Drilling for Humble Oil & Refining Co., Block 386, West Cameron Area	Louisiana-Delta Offshore Corp. Submersible 156' x 90' x 11'	Drill Barge Delta to 25 Drilling for International Drilling Co., Persian Gulf
	250'	Drilling for Humble Oil, Block 73, West Delta Area	Midcon Oil & Gas Co., Ltd.	Midcon No. 1 90 Not drilling
		Drilling off Santa Barbara, for Standard Oil of Calif.	Movible Offshore Co. Submersible 201' x 211' x 110'	"Movible No. 2" to 70 Drilling for Shell Oil Co., Block 30, West Delta Area
nar II		Drilling off San Francisco, for Shell Oil Co.	Movible Offshore Co. Submersible 200' x 146' x 67'	"Movible No. 3" to 40 Drilling for Shell Oil Co., Block 27, South Pass Area
nar III		Drilling for Shell Oil Co., Gulf of Mexico	Movible Offshore Co. Self-Propelled Drilling Tender	Rig No. 4 Drilling for Mobil Oil Co., Block 128, Eugene Island Area
nar IV		Drilling for Continental Oil Co., Gulf of Mexico	Ocean Drilling & Exploration Company Submersible 200' x 300' x 98'	"El Dorado" to 200' Drilling for Shell Oil Co., Block 7, South Marsh Island
nar V		Drilling off Libya, for Atlantic	Ocean Drilling & Exploration Company Submersible 132' x 220' x 58'	"Mr. Charlie" 40 Drilling for Gulf Oil Corp., Block 57, West Delta Area
nares		En Route to California	Ocean Drilling & Exploration Company Submersible 120' x 180' x 49'	"John Hayward" 30 Drilling for Odeco et al, Block 12, South Pelto Area
rencia		Idle—Long Beach, California	Ocean Drilling & Exploration Company Submersible 200' x 300' x 93'	"Margaret" to 60' Drilling for Humble Oil, Block 34, South Timbalier Area

The Offshore Company Self-Contained Platform 145' x 90'	Rig 25	0	Docked at Bayou Boeuf, La.
The Offshore Company Floating drilling vessel 252' x 46' x 16' draft	Offshore C-1	200'	Laid up for winter
The Offshore Company Self-elevating 13½' x 117' x 220' with fourteen 6' dia. caissons	Mobile Unit No. 52	100'	Drilling for Amoseas, Nigeria, West Africa
The Offshore Company Submersible 12' x 74' x 200' with four 6' dia. caissons	Mobile Unit No. 53	35'	Drilling for Union Oil Co. of Calif., Block 26, Vermilion Area
The Offshore Company Self-elevating 200' x 104' x 15' with eight 12' dia. towers	Mobile Unit No. 54	125'	Drilling for Shell, Block 193, Vermillion Area
The Offshore Company Self-elevating 200' x 104' x 15' with eight 42' dia. towers	Mobile Unit No. 55	180'	Drilling for Abu Dhabi Marine Areas, Persian Gulf.
The Offshore Company Self-elevating 188' x 104' x 13' with four 10' dia. caissons	Mobile Unit No. 57	100'	Leased to Texaco-Trinidad, Gulf of Paria
The Offshore Company Self-elevating 97½' x 80' x 12' with three 6' dia. caissons	Mobile Unit No. 58	100'	Docked at Bayou Boeuf, La.
The Offshore Company Self-elevating 97½' x 80' x 12' with three 6' dia. caissons	Mobile Unit No. 59	120'	Drilling for SPAFE Port Gentil, Republic of Gabon Africa
The Offshore Company Self-elevating 108' x 101' x 12' with three 6' dia. caissons	Mobile Unit No. 60	120'	Drilling for Venezuelan Sup Oil Company in Lake Maracaibo, Venezuela
The Offshore Company Floating drilling ship, 320' x 70' x 25'	Discoverer		Drilling for Mobil Oil Co., Block 240, So. Timbalier Area
Pan American International Oil Co. Self-elevating 200' x 104' with 8'-12' dia. towers	Panitoil 2		Drilling for Kuwait Shell Petroleum Development Co., Ltd., operated by Southeastern Drlg. Co.
Penrod Drilling Company Submersible 196' x 134'	Rig 50	46'	Drilling for Mobil Oil Co., Block 126, Eugene Island Area
Penrod Drilling Company Submersible 150' x 190'	Rig 51	to 60'	Drilling for The California Co., Block 23, Bay Marchand Area
Penrod Drilling Company Submersible 198' x 174'	Rig 52	100'	Drilling for Shell Oil Company in Galveston, Bucaneer Area, Offshore Texas
Place Gas & Oil Co., Ltd.	Barge 2		Drilling for Self, Lake Erie
Place Gas & Oil Co., Ltd.	Barge 3		Drilling for Self, Lake Erie
Reading & Bates Offshore Drilling Company Self-elevating	"C. E. Thornton"	to 110'	Drilling for Pakistan Sun Oil, Karachi, W. Pakistan
Reading & Bates Offshore Drilling Company Floating Drilling Vessel	"Catamaran C. P. Baker"		Drilling for Pan American Petroleum Corp., Block 103, W. Delta Area
Reading & Bates Exploration Co. Self-elevating	"Mr. Louie"	to 120'	Drilling for Shell Oil Co., Block 160, So. Timbalier Area

The Shell Co. of Qatar, Ltd.	Seashell	100'	Drilling for Shell off Qatar
Southeastern Drilling Corp. Submersible 111' x 90' x 156' with four pontoons	Rig 22	25'	Drilling for Calco, Block 107, Ship Shoal Area
Tidal, Inc. Self-elevating Deck 258' x 104', pad 200' x 180' with four 10' dia. columns	"Mr. Gus II"	150'	Drilling for Continental Oil Co., Block 72, Grand Isle Area
Western Offshore Drilling & Exploration Co., Floating drill barge	M/V Torry		Singapore Harbor
Western Offshore Drilling & Exploration Co. Floating drill barge 254' x 68'	"Western Offshore No. 1"		Drilling offshore Santa Barbara, Calif. for Phillips Petroleum
Western Offshore Drilling & Exploration Co.	Western Offshore No. II		Drilling in Cook Inlet, Alaska for Pan-American et al
Zapata Off-Shore Company Self-elevating 194' x 152' overall. Three 173' legs.	"Vinegaroon"	to 105'	Drilling off Trinidad, W.I.
Zapata Off-Shore Company Self-elevating 20' x 80' x 140', with three 152' triangular legs	"Scorpion"	80	Drilling in Block 188, Eugene Island Area
Zapata Off-Shore Co. Floating drill barge	"Nota 1"		Lavingston Shipyard, Orange, Texas
Zapata Offshore Co., Floating drill barge	"Sidewinder"		On location in Borneo
Zapata Off-Shore Co. Self-elevating Three 376-ft. legs	"Mavrick"	250'	UNDER CONSTRUCTION

Drilling Tenders

Arabian American Oil Co.	Aramco Drill Tender—1		Drilling in Persian Gulf
The California Company Converted LST, 328' x 50'	S-21	50'	Idle
The California Company Converted LST, 328' x 50'	S-22	49	Idle
The California Company Converted LST, 328' x 50'	S-23		Mothballed
The California Company LST, 328' x 50'	S-24	46'	Block 41, Main Pass Area, Noble Drlg. Co.
The California Company ST, 328' x 50'	S-25	48	Bay Marchand, La., Noble Drilling Co.
The California Company LST, 328' x 50'	S-26	45'	Idle
CATC Group New tender, 260' x 54'	"Ernie Miller"	50'	Moved to West Delta Block 58A Platform
CATC Group New tender, 260' x 54'	"Jack Cleveley"	122	West Delta Area, Block 79, "E" Platform
Delta Marine Drilling Co. Converted LST, 326' x 50'	"Joseph Zeppa"		Block 16, Grand Isle Area Humble Oil & Refining Co.
Gulf Oil Corporation New tender, 272' x 60'	"Pelican"		Block 152, S. Timbalier Area, self
Humble Oil & Refining Co. Converted LST, 328' x 50'	ST-1		Storage, Orange, Texas
Humble Oil & Refining Co. Converted LST, 328' x 50'	ST-2		Storage, Orange, Texas
Humble Oil & Refining Co. Converted LST, 328' x 50'	ST-4		Storage, Orange, Texas
Humble Oil & Refining Co. Converted LST, 328' x 50'	ST-5		Storage, Orange, Texas
Humble Oil & Refining Co. Converted LST, 328' x 50'	ST-7		Storage, Orange, Texas

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 770

BETHLEHEM STEEL COMPANY, *Petitioner,*

v.

CHARLES T. SAMUELSON, *Respondent*

PETITIONER'S REPLY BRIEF

W. BROWN MORTON, JR.
425 13th Street, N. W.
Washington, D. C. 20004

STANTON T. LAWRENCE, JR.
247 Park Avenue
New York, N. Y. 10017

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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1. The first of the "Questions Presented", as stated in Respondent's Brief, is incorrect. This first Question, correctly stated, is "Did the Court of Appeals err in its review of the District Court's ruling on validity when it acted under a supposed rule of law which would place upon an accused infringer the burden of establishing the *legal conclusion* of invalidity beyond a reasonable doubt?"

It is Petitioner's contention that the "reasonable doubt rule" is a rule of evidence concerning the proof of evidentiary facts and an erroneous application of

this rule is clearly shown when a court requires a defendant to "prove" beyond a reasonable doubt the ultimate legal, or even constitutional, conclusion of invalidity for failure to meet the standard of invention.

2. The second of the "Questions Presented", as stated in Respondent's Brief, is based upon an outright mis-statement of fact, namely that "there is no dispute in the record on the controlling facts".

The physical structure of Mr. Gus II was stipulated, but the significance of the structure in terms of mode, manner, and principle of operation was sharply in dispute and formed the basis of conflicting testimony and scientific conclusions of technically qualified witnesses in the trial court.

3. At pages 5 and 6, Respondent requests this Court to notice judicially the fact that mobile units are operating outside the Gulf Coast area and offers reproduced pages from "Offshore & Gulf Coast Oil Reporter", December, 1963, to induce this Court to reach the conclusion that, as a practical matter, the patent in suit could or would be litigated in Circuits other than the Fifth Circuit.

Respondent's effort to mislead the Court on this issue is most reprehensible and should not be countenanced. It is certain that Respondent, a Fifth Circuit resident, would not, as a matter of common sense, bring an infringement action in any other circuit unless the defendant involved were not amenable to suit in that Circuit.

On the pages Respondent has reproduced from "Offshore", there are listed 81 "mobile units". Of these 81 rigs, 16 are shown to be outside the United States

and hence their present use is incapable of infringing a United States patent; of the remaining 65 rigs, 47 are concentrated in the Gulf of Mexico. Most important, of *all* the rigs identified on the pages Respondent has reproduced from "Offshore", only two are known to have these characteristics required by the claims of the patent in suit:

> a submersible mat;
>
> columns extending upwardly from the mat;
>
> a platform movable vertically on the columns; and
>
> spuds within the columns extendible downwardly into the marine floor.

These two are Mr. Gus II and the S-66.

Both Mr. Gus II and the S-66 were built on the Gulf Coast and have been used since that time only in the Gulf of Mexico. Wherever the headquarters of the owners of the S-66 may be located, it is obvious that Samuelson would bring his action only in the place where the infringement was being committed, that is, in the Fifth Circuit.

Since Respondent relies on the listing of rigs in "Offshore", which Petitioner agrees is a reasonably authoritative publication, Petitioner will quote from that publication and the equally authoritative "The Oil and Gas Journal" to support its assertion that it is improbable that the patent in suit will be infringed outside the Fifth Circuit:

> "The nation's first offshore production came from wells slant-drilled from California beaches out under the Pacific. Because the floor of the Pacific falls steeply away from the shoreline, only a narrow band of submerged land is offered to the

oil hunter's drill; and as a consequence, techniques for deep-water drilling and underwater completions have developed much more rapidly on the West Coast than anywhere else in the world." *Offshore,* August 20, 1963, page 25.

"The Ferris* is the only mobile platform working off California and only the second ever to drill in California waters. The first, the Pacific Driller*, has been converted to a permanent platform in Conception field, about 25 miles west of the present wildcat. Most drilling off the state is done either by floating vessels or from permanent structures." *The Oil and Gas Journal,* July 15, 1963, page 86.

4. Commencing at page 6, Respondent argues that there is no conflict between the decision in the instant case respecting validity and decisions of other courts.

It is Petitioner's position that the Court of Appeals erred in deciding the instant case through application of an erroneous principle of law which places a burden upon a defendant asserting a defense of invalidity of "proving" the ultimate conclusion of invalidity "beyond a reasonable doubt". The argument of Respondent does not meet this issue.

Respondent's argument is based on the erroneous premise that there was a conflict of testimony as to the facts bearing on the *validity* of the patent. In truth, the existence of the prior art was undisputed, and the conflicts of testimony to which Respondent adverts were with respect to the significance of the

---

*Neither rig had the mat or ground anchor required by the Samuelson claims, which is the element of Mr. Gus II that makes it unsuited for the West Coast.

prior art on the *effective scope* to be accorded the patent claims.

Thus, if Dean Nedderman found it difficult to satisfy Respondent's counsel as to which was the "most pertinent" of the prior art references, it was not because he had any doubt as to what the references showed or how their structures or the patent structures or Mr. Gus II compared as a matter of engineering. It was rather because the "pertinence" of a reference to the legal conclusion of validity is a question for a court and not for a dean of an engineering school.

5. On page 12, Respondent suggests that in confining its Petition for Rehearing in the Court of Appeals to the infringement issue, Petitioner may be said to have waived its position that that Court erred as to validity. In truth, Petitioner knew, from the accurate statement made by the Court of Appeals of the position Petitioner had asserted, that that Court had neither "overlooked nor misapprehended" what Petitioner had said about validity. Instead, Petitioner was convinced that the Court of Appeals had "erred" in its ruling on validity, but Petitioner properly did not reargue the point in that Court. It is not the function of a rehearing petition to merely reargue; it *is*, however, the function of this, and every, appellate tribunal to correct *error* below, and for that reason Petitioner now asks this Court to act.

6. Commencing at page 12, Respondent argues that there is no conflict between the decision of the Court below respecting infringement and the decisions of other courts. This argument is based upon the erroneous premise that the structures involved and the mode, manner and principle of their operation were simply

and easily comprehended matters which were capable of summary disposition through a mere comparison of structures. The error of this is demonstrated by errors in the opinion of the Court of Appeals which evidence the misunderstanding of that Court itself with respect to the mode, manner and principle of operation of the structures involved. The fact of the matter is that the structure disclosed in the patent in suit is incapable of operating in the same manner as Mr. Gus II and Mr. Gus II is incapable of operating in the same manner as the structure disclosed in the patent in suit in water depths in which it is customarily operated. As stated in the Petition for Certiorari,

> "The opinion reflects material errors of the Court of Appeals concerning the structures and modes of operation of the patented, the prior art, and the accused devices, errors not made by the trial court".

Respondent's Brief in Opposition, understandably, entirely ignores these facts and the issue they present, for they go to the heart of the reason for Rule 52(a).

7. In short, Respondent would have this Court believe

   (a) that on the issue of validity there was conflicting testimony as to facts; hence the Court of Appeals properly invoked a rule requiring defendant to prove such "facts" beyond a reasonable doubt; and

   (b) that on the issue of infringement there was no conflict; hence the Court of Appeals was entitled to determine infringement as a matter of law.

This is a complete misrepresentation of the situations of both law and fact which actually existed. The truth is precisely the contrary of the propositions asserted by Respondent.

8. It is clear that, whether the patent in suit "dominates" an industry or not, the patent judgments of the Fifth Circuit Court of Appeals do dominate the most important area of the U. S. offshore industry and the only area in which the patent in suit is likely to pose a threat. Only by granting this petition for certiorari can the nationally vital search for Gulf Coast offshore oil be rid of the incubus of the invalid and over-valued Samuelson patent and others like it that may be validated or over-valued if the Court of Appeals is permitted to perpetuate its aberrant mistakes.

CONCLUSION

The Petition for a Writ of Certiorari should be Granted.

W. Brown Morton, Jr.
Stanton T. Lawrence, Jr.
Counsel for Petitioner